FILED
FEB 2 1956
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

October Term, 1955

No. 658

NORTH AMERICAN AIRCOACH SYSTEMS, INC. (also known as NORTH AMERICAN AIRLINES AGENCY CORP., and NORTH AMERICA AIRLINES AGENCY CORP.), TWENTIETH CENTURY AIR LINES, INC., JAMES FISCHGRUND, JACK B. LEWIN and STANLEY D. WEISS,

Petitioners,

vs.

NORTH AMERICAN AVIATION, INC.,

Respondent.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

WALTER J. DERENBERG,
165 Broadway,
New York 6, N. Y.
HARDY K. MACLAY,
1317 F St., N. W.,
Washington 4, D. C.
SIDNEY FISCHGRUND,
ROBERT S. DICKERMAN,
756 South Broadway,
Los Angeles 14, California,
Attorneys for Petitioners.

ALEXANDER, MALTITZ,
DERENBERG & DANIELS,
165 Broadway,
New York 6, N. Y.,
Of Counsel.

The Myers Legal Press, Los Angeles. Phone VAndike 9007.

TOPICAL INDEX

PAGE

Opinions below 1

Jurisdiction 2

Questions presented 2

Statement of the case 3

Reasons for granting the writ 6

Conclusion 17

Appendices—Opinions and judgment below:

Appendix A. Judgment for injunction ..... App. p. 1

Appendix B. Opinion of the United States Court of Appeals for the Ninth Circuit ..... App. p. 4

TABLE OF AUTHORITIES CITED

CASES

American Automobile Association and California State Automobile Association v. American Automobile Owners Association et al., 14 U. S. P. Q. 263 10

American Automobile Insurance Company et al. v. American Auto Club, 184 F. 2d 407 8

Canal Co. v. Clark, 13 Wall. 311 (1871) 6

Columbia Mill Company v. Alcorn, 150 U. S. 460 7

Eastern-Columbia, Inc. v. Waldman, 30 Cal. 2d 268 10

Elgin Natl. Watch Co. v. Illinois Watch Co., 179 U. S. 665 8

Hamilton Shoe Co. v. Wolf Brothers, 240 U. S. 251 7

McGraw-Hill Pub. Co., Inc. v. American Aviation Associates, Inc., 117 F. 2d 293 11

North American Airlines, Inc. v. Civil Aeronautics Board, American Airlines, Inc., Intervenor (Unrep.) (D.C. Cir., June 23, 1955), cert. granted Nov. 14, 1955, No. 410 of Oct. 10, 1955 14

Olin Mathieson Chemical Corporation v. The Western States Cutlery and Manufacturing Company et al., 107 U. S. P. Q. 257 ..... 11, 12

STATUTES

Civil Aeronautics Act, Sec. 411 14

United States Code, Title 28, Sec. 1254(1) 2

IN THE

Supreme Court of the United States

October Term, 1955

No. .....

NORTH AMERICAN AIRCOACH SYSTEMS, INC. (also known as NORTH AMERICAN AIRLINES AGENCY CORP., and NORTH AMERICAN AIRLINES AGENCY CORP.), TWENTIETH CENTURY AIR LINES, INC., JAMES FISCHGRUND, JACK B. LEWIN and STANLEY D. WEISS,

Petitioners,

vs.

NORTH AMERICAN AVIATION, INC.,

Respondent.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit entered in the above case on September 28, 1955.

Opinions Below.

The judgment of the United States District Court for the Southern District of California [R. Vol. 1, p. 88] is printed in Appendix A, hereto.

The opinion of the Court of Appeals for the Ninth Circuit, printed in Appendix B, hereto, *infra,* Appendix page 4, is reported at 107 U. S. P. Q. 68.

Jurisdiction.

The opinion of the Court of Appeals for the Ninth Circuit was entered on September 28, 1955. Rehearing was denied on November 7, 1955. The jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254(1).

Questions Presented.

1. May the user of an unregistered tradename comprising a common geographical designation, "North American," engaged primarily in the manufacture of aircraft, selling its products solely to governmental agencies, acquire exclusive rights in that name against a company whose business is restricted to airline transportation, selling its services to the consuming public and not engaged in any competition whatsoever with such user.

2. Even if a geographic designation such as "North American" may have acquired a secondary meaning in connection with machines produced by a leading manufacturer of aircraft, was the court below justified in treating such unregistered term as tantamount to a "strong" registered trademark, and issuing an absolute permanent injunction against its use by a noncompetitor?

3. Was it not error for the Court of Appeal to find as a matter of law that respondent, although engaged only in the manufacture of aircraft with Government and Governmental agencies as its only customers, was entitled to the exclusive use of the term "North American" even in connection with air transportation, on the ground that "conditions may change" and that respondent may at some future time want to expand its operations into petitioners' field of operations?

Statement of the Case.

The respondent, a manufacturer of military aircraft, filed an action for injunction based on unfair competition claiming the sole and exclusive right to the use of the name "North American" in connection with the entire aviation industry [R. Vol. 1, p. 8].

The respondent charged that petitioners, who are operating a large unscheduled airline under the trade name, North American Airlines, have unlawfully and fraudulently appropriated the name "North American" for the purpose of benefiting from the celebrity and good will developed by respondent.

It was further charged that the name "North American" had acquired a secondary meaning in connection with respondent's good will and that the petitioners' use of the name "North American" in connection with airplanes, tickets, uniforms, time and fare schedules, and in other similar ways, led the general public falsely to believe that a connection in trade existed between the respondent and the petitioners' organization. [R. Vol. 1, p. 16.]

The petitioners denied that respondent had any exclusive right to the use of the name "North American" except in the manufacture of aircraft and aircraft parts, which is the only business in which respondent is presently engaged [R. Vol. 1, p. 4].

The respondent was organized in 1928 as a holding company, and for several years its principal function was the holding of stock in operating companies engaged in the manufacture of aircraft and parts and commercial airlines, such as Douglas, Sperry, TWA, Eastern Airlines, and others [R. Vol. 1, p. 4].

From 1934 to 1938, the respondent operated two divisions—one, a manufacturing division, under the name "North American Aviation Company," and the other, an air transportation division, under the name "Eastern Airlines." In 1938, the respondent completely divested itself of any and all connections with the air transportation business by selling its interests in the air transportation division. At no time did the respondent operate, either directly or as a subsidiary airline, an air transportation business under its own name or petitioners' name or under any other name comprising the term "North American."

Since respondent sold its air transportation division known as "Eastern Airlines" in 1938, it has not, either directly or indirectly, had any interest in any air transportation business under any name. It has never manufactured or sold any aircraft for use by a commercial airline [R. Vol. II, pp. 536-537; Vol. I, p. 470]. Its products are purchased by experts who are highly trained and are specialized in their field [R. Vol. I, pp. 468, 504].

All advertising done by the respondent and all publicity received by it has been solely in connection with aircraft manufacture.

The petitioners are engaged in the air transportation business. All advertising done by the petitioners and all publicity received by them has been in connection with the air transportation business. They have developed a substantial business and good will, having expended approximately $1,900,000.00 for advertising since March, 1950 [R. Vol. III, p. 1255]. They employ 300 persons, operating 29 sales offices in principal cities of the United States, and have expended over $100,000.00 for purchasing and installing signs and billboards. The petitioners

in most of their advertising display the Douglas aircraft, which is an airplane manufactured by the Douglas Aircraft Company, a competitor of the respondent.

Petitioners denied that the respondent had any exclusive right to the use of the name "North American" except in connection with the manufacture of aircraft, and denied that they had intentionally appropriated the good will and reputation of the respondent.

It was petitioners' principal contention that neither respondent nor anyone else could acquire exclusive rights in the use of the designation "North American" as against others operating in the same geographic area, and that they clearly had a right to use the name of the Continent in which they did business. Moreover, it was petitioners' position that, since they are not engaged in the manufacture of airplanes for sale to Governmental agencies, which is respondent's sole business, no injunction should be granted against them in connection with the use of the name "North American" in the limited field of air transportation in which they are operating.

The trial court held in favor of respondent and issued a permanent injunction against use by the petitioners of the name "North American," but did not grant an accounting of profits or damages. The Court of Appeals affirmed this judgment. It held, *inter alia,* that respondent's name, "North American," had acquired a secondary meaning in connection with the entire aviation industry to such an extent that it identified the respondent only. While conceding that it was "extremely difficult" to give a proprietary connotation to a geographic term, the court reached the conclusion that the name "North

American" as used by respondent was entitled to "as complete protection as if it were a strong mark at the inception." Although noting that the direct customers of respondent at the present time were solely the Government and Governmental agencies, the court observed that "conditions may change" and respondents should not be prevented "from in the future engaging in air transport, which was one of the purposes for which it was organized. . . ."

Reasons for Granting the Writ.

1. The Decision of the Court Below in the Instant Case Is in Conflict With All Applicable Previous Decisions of This Court.

The principle announced by the court below that the common geographic phrase "North American" may be exclusively appropriated by one concern as against a non-competing third party conflicts in principle and in law with a long line of decisions by this Court, under which no exclusive rights may be acquired in the use of names of this kind even as against a competitor. Thus, is was held by this Court long before 1900 that no one could claim exclusive rights in the word "Lackawanna," that being the name of a region in Pennsylvania. In *Canal Co. v. Clark*, 13 Wall. 311, 321 (1871), the Court said:

> "It must be then considered as sound doctrine that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation."

In 1893, this Court again held, in a unanimous decision, that the word "Columbia" could not be appropriated exclusively by one flour manufacturer. In *Columbia Mill Company v. Alcorn*, 150 U. S. 460, 465 (1893), injunctive relief was denied even against a *direct competitor* who had appropriated plaintiff's brand name "Columbia" for flour. This Court there said:

> "The word 'Columbia' is not the subject of exclusive appropriation under the general rule that the word or words, in common use as designating locality, or section of a country, cannot be appropriated by any one as his exclusive trade-mark."

and again (at p. 466).

> "The appellant was no more entitled to the exclusive use of the word 'Columbia' as a trade-mark than he would have been to the use of the word 'America' or 'United States,' or 'Minnesota," or 'Minneapolis.' These merely geographical names cannot be appropriated and made the subject of an exclusive property."

The most recent pronouncement by this Court on this exact point may be found in *Hamilton Shoe Co. v. Wolf Brothers*, 240 U. S. 251 (1915), in which the Court held that the words "The American Girl," as applied to shoes, were not merely a geographical or descriptive term and were, therefore, eligible for exclusive appropriation as a trademark; in other words, the words "The American Girl" were held to be a fanciful and arbitrary designation in connection with shoes. However, this Court took pains to explain that, in upholding "The American Girl" trademark for shoes, it did not intend to overrule or modify its earlier above-mentioned decisions in which the names "Lackawanna" and "Columbia" were

held incapable of exclusive appropriation (as was also the word "Elgin" in connection with watches in *Elgin Natl. Watch Co. v. Illinois Watch Co.*, 179 U. S. 665 (1900)). On the contrary, the decision went on to say at page 257:

> "If the mark here in controversy were 'American Shoes' these cases would be *quite in point.*" (Italics added.)

In other words, there is a clear indication here that the phrase "American Shoes" could not be exclusively appropriated by any one concern under any circumstances, even though it may have acquired a secondary meaning.

The ruling by the court below, enjoining the use of the words "North American" not in connection with the manufacturing of airplanes but in relation to a transportation service on the ground that the words "North American" must be considered tantamount to a "strong" trademark is contrary in principle and in application to all cases previously decided by this Court with regard to the scope of protection to which geographical trade names have been held entitled.

2. The Decision of the Court Below Is in Direct Conflict With Earlier Decisions by the Same Court and by the Supreme Court of the State in Which It Is Located.

It is significant that not even a footnote reference is made in the court's opinion to its own previous decision in *American Automobile Insurance Company et al. v. American Auto Club,* 184 F. 2d 407 (9th Cir. 1950), in which the court in a unanimous opinion refused to enjoin use of the words "American Auto" and "The American Auto Club" even with regard to that part of the

defendant's business which related to the sale and solicitation of insurance policies (the plaintiff corporations were primarily engaged in writing automobile insurance). The plaintiffs had advertised under the name "American Associated" and similar names. The court below there said:

> "The words 'American' and 'Auto' are used in identification of many businesses of diverse nature. The Court found that these words are not unique either individually or in combination. The evidence disclosed several instances where in the combination 'American Auto' has been used in the identification of automobile clubs. As such it is a common name in that field."

and again:

> "The name American Auto Club suggests an association for the purpose of engaging in the business usually engaged in by automobile clubs and not necessarily including the insuring of members. The word 'Club' is descriptive of its objectives and distinguishes defendant from plaintiff and from the identity which they draw to them through the restricted use of 'American Auto'."

The court further observed that the confusion which plaintiff feared was "ephemeral" even though the defendant, to some extent, operated in the same line of business, while in the present case, the court went out of its way to point out that while there was presently no direct competition between the parties, the respondent may at some future time re-enter the air transportation business and that it should be given preemptive rights to do so by reserving to it the exclusive right to use the name "North American." Instead of following, or even

citing, this precedent, the court below gave primary significance to the decision by the Supreme Court of the State of California in *Eastern-Columbia, Inc. v. Waldman*, 30 Cal. 2d 268 (1947), in which the plaintiff, operating a furniture establishment under the trade name "Eastern-Columbia," was held entitled to enjoin a direct competitor also located in the city of Los Angeles from operating a furniture store under the name "Western Columbia." But the court below did not refer to the earlier decision of the California Supreme Court in *American Automobile Association and California State Automobile Association v. American Automobile Owners Association et al.*, 14 U. S. P. Q. 263 (1932), which offers a much closer analogy to the present case. The plaintiff, American Automobile Association, there sought to enjoin defendant association from doing business under the name "American Automobile Owners Association." The plaintiff used the well known emblem, AAA, while defendant used AAOA. The California Supreme Court there emphasized that "generic terms and words descriptive of place are not subject to exclusive appropriation." It further said, at page 266:

> "No legal objection could be urged against the formation of an association to be known as the American Automobile Association of South America, or the American Automobile and Motor Association, as such."

It will thus be seen that, in the only two previous cases before either the court below or the Supreme Court of the State in which it is located, in which the question of exclusive rights in the word "American" was involved, the plaintiffs were not even given limited protection despite the fact that there was a more direct competi-

tion, or possibility of such competition, present in those cases than the conjectural future competition to which the court below referred after having gone "all out" to find some evidence of alleged "direct" competition by petitioners' use of the name "North American" on the Douglas aircraft which are currently used for their daily operations. Moreover, the facts that petitioners, as the largest nonscheduled airline, have flown a billion passenger miles without an accident and have handled up to half a million passengers until now was referred to by the court below not as elements of good will which petitioners have built up over the course of years, but as additional grounds for emphasizing respondent's need of protection.

3. The Decision of the Court Below Is in Direct Conflict With the Decision of the Court of Appeals for the District of Columbia in *McGraw-Hill Pub. Co., Inc. v. American Aviation Associates, Inc.*, 117 F. 2d 293 (1940), and With the Most Recent Decision by the Court of Appeals for the Tenth Circuit in *Olin Mathieson Chemical Corporation v. The Western States Cutlery and Manufacturing Company, et al.*, 107 U. S. P. Q. 257 (1955).

In the former case, the plaintiff, which had been publishing a magazine under the name "Aviation," sought to enjoin defendant from publishing a periodical under the name, "American Aviation." The court failed to find either trademark infringement or unfair competition. In an opinion by the late Chief Justice Vinson, who was then an Associate Justice of the Court of Appeals, it was pointed out that no exclusive rights could be acquired in the descriptive word Aviation, and that the defendant's use of the title, "American Aviation," even for a publication of the same character and covering the same field,

did not constitute unfair competition. Mr. Justice Vinson said, *inter alia,* at page 296:

> "The mere fact that the word, American, appears in plaintiff's sub-title and in defendant's title is not, as plaintiff contends, unfair. The words of the English language make many appearances, and each time they must be taken in their context. The 'winged' designs, even upon a casual comparison, can be seen to be distinct, and the plaintiff has not used his regularly. We see nothing unfair in the comments published by 'American Aviation' in regard to the suit."

The differences which were found to exist between plaintiff's and defendant's magazines with regard to contents, form, and appearances are certainly not as obvious as those between the manufacturing operations of the respondent here and the transportation services offered on a nationwide basis by petitioners.

The view expressed by the court in the "Aviation" case was most recently applied by the Court of Appeals for the Tenth Circuit in *Olin Mathieson Chemical Corporation v. The Western States Cutlery and Manufacturing Company et al., supra,* decided on November 12, 1955. The plaintiff there sought an injunction restraining defendants from using the trademark "Western" on knives. The plaintiff had been using the term "Western" since 1896 for shotguns, ammunition, cartridges and related products. Although plaintiff had nine registrations for the trademark "Western," the complaint was dismissed on the ground that "Western" was a common word in general use and entitled to narrow construction. The court said:

> "There are any number of enterprises which employ this word in describing their business."

It further said:

> "It is our view that under the narrow construction which must be adopted in this case there are no appropriate descriptive words which would bring cutlery, pocket knives and hunting knives under the protection of the trademark 'Western.' The only words relating even remotely to hunting knives are the words 'sporting goods.' That phrase again is one of broad meaning. If it is sufficiently definite to apply to hunting knives, why would it not also apply to hunting caps, coats, trousers, shoes, socks, shirts, compasses, camp cook stoves, cooking kits, as well as hundreds of other articles sportsmen use. Such a construction would tend to give appellant a monopoly of the trademark 'Western' on practically everything that is made to be sold to sportsmen." (107 U. S. P. Q. 257, at page 259.)

We submit that the court below permitted itself to be influenced by considerations of local pride and patriotism, rather than by well established rules of law as laid down in previous decisions by this Court as well as by the courts in other jurisdictions and, indeed, by the court below in earlier analogous situations. No one will deny the enormous contribution which the respondent made toward our recent war effort, and that in connection with the manufacture of aircraft, the words "North American" may be exclusively associated with the respondent; but no principle of trademark law or unfair competition would justify the grant of a practical monopoly in the words "North American" to any one concern even as against a direct competitor, and certainly not against a concern which is not engaged in manufacturing but solely in the rendering of transportation services.

4. Most Important of All: The Decision of the Court Below Is Not Only in Conflict With the Decision by the Court of Appeals for the District of Columbia in *North American Airlines, Inc. v. Civil Aeronautics Board, American Airlines, Inc., Intervenor* (not yet reported), in Which This Court Has Already Granted Certiorari, on November 14, 1955, Under Number 410, October 10, 1955, but Unless Likewise Reviewed by This Court Would Make the Controversy Now Before This Court in Number 410 Moot and Meaningless.

The question already before this Court in Number 410 relates to an Order issued by the Civil Aeronautics Board under Section 411 of the Civil Aeronautics Act, in which the present petitioners were found guilty of an "unfair or deceptive practice" in using the name "North American Airlines," as distinguished from the name "American Airlines," as used by the intervenor in that proceeding. As a result, the present petitioners were ordered to cease and desist from engaging in air transportation under the name "North American" or any other name including the word "American." The Board ruled that the use by petitioners of any name including the word "American" or the words "North American" would, in effect, be an infringement of the rights of American Airlines and constitute an act of unfair competition with the latter. The Court of Appeals for the District of Columbia in Case Number 410, which is presently before this Court, not only set aside the Board Order on the ground that the Board had exceeded its authority by passing upon what primarily appears to be a proper subject for private litigation between the parties, but indicated at the same time in an opinion written by Judge Danaher that it was not at all certain that American Airlines could prevail

against the petitioners even in private litigation involving the latter's alleged exclusive rights to the words "American" or "North American." In other words, the court expressly observed that American Airlines, a *direct*, competitor of the petitioners, might not be able to restrain petitioners from using the designation "North American," while the court below in the instant case did not hesitate to brand petitioners as unfair competitors, even though respondent admittedly has not for some time past operated any airline whatsoever. While disclaiming any intention to prejudge the outcome of any future private litigation between American Airlines and the petitioners, Judge Danaher made the following observation, which reflects a truly objective and detached approach to the question now before the Court:

> "There are many instances, of which the public must be presumed to have knowledge, of similarities in airlines designations indicating a not uncommon practice of this sort in the air transportation industry. Exhibits in the record here disclose airlines routes allocated by the Board to All American Airways, Inc., American Airlines, Inc., Northeast Airlines, Inc., Eastern Air Lines, Inc., Northwest Airlines. Inc. and Western Airlines, Inc. Pan American and Air American were previously mentioned. Phonetic differences, lack of emphasis in petitioner's use of the disputed term, possible failure of the intervenor's advertising campaigns, differences in service, rates and the elements of the airlines traveling public each has sought to reach, would seem to serve here to distinguish the two competing companies." (Decision No. 12041, p. 18.)

and again:

> *"We will not say that under no circumstances can name appropriation in simulation of or in general resemblance to the name of another air line result in an unfair trade practice or an unfair method of competition, quite the contrary. But the mere combination of the words 'North' and 'American,' the latter so commonly used in business enterprises, even in the airlines industry, without more—much more than is disclosed upon this record—is not the unfair practice or the unfair method of competition over which the Board, in the public interest, has jurisdiction."* (pp. 19-20.)

Having agreed to review the Court of Appeals decision in Number 410, involving a question of alleged unfair competition between two directly competing airlines, *to wit:* American Airlines and North American Airlines, this Court, we submit, can not let stand unchallenged and unreviewed a decision which outlaws any use of the words "North American" by petitioners as a result of a private complaint by an aircraft manufacturer. If the decision of the court below were permitted to stand, the petitioners would be permanently unable to do business under their present name, even if this Court should uphold the decision of the Court of Appeals for the District of Columbia in Number 410 and indicate thereby that the Civil Aeronautics Board had exceeded its authority in adjudging petitioners to be guilty of unfair practices as a result of use of the name "North American." If, as the court's opinion in Number 410 strongly suggests, the use of petitioners' name "North American Airlines" may not be in infringement upon American Airlines' rights, although these two parties are in direct daily competition, then that

court's general approach and position certainly cannot in any way be harmonized with the drastic and unprecedented ruling of the court below in the present case.

We submit that Number 410 cannot be effectively reviewed and decided by this Court without at the same time passing upon the collateral issues presented in the instant petition.

Conclusion.

For the foregoing reasons, this petition for certiorari should be granted.

Respectfully submitted,

WALTER J. DERENBERG,
HARDY K. MACLAY,
SIDNEY FISCHGRUND,
ROBERT S. DICKERMAN,
Attorneys for Petitioners.

ALEXANDER, MALTITZ, DERENBERG
& DANIELS.
Of Counsel.

APPENDIX A.

In the District Court of the United States for the Southern District of California, Central Division No. 13412-PH.

North American Aviation, Inc., Plaintiff, vs. North American Aircoach Systems, Inc. (Also Known as North American Airlines Agency Corp., and North America Airlines Agency Corp.,), Twentieth Century Air Lines, Incorporated, James Fischgrund, Jack B. Lewin and Stanley D. Weiss, Defendants.

Judgment for Injunction.

The above-entitled action came on regularly for trial and was tried on November 17, 20, 24, and 25, 1953, and December 1, 2, 3, 4, 8, 9, 15, 16, 17, 18, and 21 and 22, 1953, and January 7 and 8, 1954, before the Court without a jury, and the Court having duly considered the evidence and being fully advised in the premises and having made its Findings of Fact and Conclusions of Law and Order for Judgment; now, therefore,

It Is Hereby Ordered, Adjudged and Decreed by the Court as follows: [239]

1. Defendants North American Aircoach Systems, Inc., a New York corporation; North American Airlines, Inc., a North Carolina corporation, named in the complaint herein as Twentieth Century Air Lines, Incorporated; James Fischgrund, Jack B. Lewin and Stanley D. Weiss, and each of them, and their, and each of their, officers, agents, servants, employees and attorneys, and all persons in active concert or participation with them or any of them, be and they hereby are permanently enjoined and restrained from using or causing

or sanctioning the use of, in any manner whatever, on or in connection with airplanes or in any phase of the aviation industry (including, without limitation, the transportation of persons, mail or property by air, and the advertising, offering for sale or sale of airline tickets), the name "North American," or any name of which the name "North American" forms a part (including, without limitation, the names "North American Aircoach Systems, Inc.," "North American Airlines Agency Corp.," "North American Airlines Inc.," and "North American Airlines"), or any name so resembling the name "North American" as to be likely to cause confusion.

2. Defendants North American Aircoach Systems, Inc., a New York corporation; North American Airlines, Inc., a North Carolina corporation, named in the complaint herein as Twentieth Century Air Lines, Incorporated; James Fischgrund, Jack B. Lewin and Stanley D. Weiss, and each of them, and their, and each of their, officers, agents, servants, employees and attorneys, are hereby directed and ordered to deliver up to the Clerk of this Court, for destruction, all advertisements, cards, pamphlets, posters, schedules, lists, signs and all other material bearing the name "North American," or any name of which the name "North American" forms a part (including, without [240] limitation, the names "North American Aircoach Systems, Ins.," "North American Airlines Agency Corp.," "North American Airlines, Inc.," and "North American Airlines"), or any name so resembling the name "North American" as to be likely to cause confusion, and all plates, molds and other matter for making the same, in the possession or under the control of them or any of them.

3. Plaintiff North American Aviation, Inc., a corporation, shall recover from the defendants North American Aircoach Systems, Inc., a New York corporation; North American Airlines, Inc., a North Carolina corporation, named in the complaint herein as Twentieth Century Air Lines, Incorporated; James Fischgrund, Jack B. Lewin and Stanley D. Weiss, and each of them, the costs and disbursements of this action, taxed in the amount of $5,433.30.

Dated this 4th day of February, 1954; 4:40 p. m.

/s/ PEIRSON M. HALL,
United States District Judge.

Receipt of copy acknowledged.

[Endorsed]: Filed February 4, 1954.

Docketed and entered February 5, 1954. [241]

APPENDIX B.

United States Court of Appeals for the Ninth Circuit.

North American Aircoach Systems, Inc. (also known as North American Airlines Agency Corp., and North America Airlines Agency Corp.), Twentieth Century Air Lines, Incorporated, James Fischgrund, Jack B. Lewin and Stanley D. Weiss, Appellants, vs. North American Aviation, Inc., Appellee. No. 14,271. Sep. 28, 1955.

Upon Appeal from the United States District Court for the Southern District of California Central Division.

Before: Stephens and Fee, Circuit Judges, and Ling, District Judge.

James Alger Fee, Circuit Judge:

OPINION.

North American Aviation, Inc., filed action for injunction on account of unfair competition, claiming the sole and exclusive right to use the name "North American" in connection with airplanes and aviation. Complete diversity of citizenship between plaintiff and all defendants founded jurisdiction in the District Court, where the action was initiated. It was charged by the complaint that defendants have unlawfully and fraudulently intended and undertaken to appropriate the name and the benefit of the celebrity and good will developed by plaintiff, which resulted in a secondary meaning acquired by the name in connection with all phases of aviation. The appropriation is said to have resulted pursuant to a fraudulent conspiracy in which the individual defendants were the prime movers. It was alleged that defendants have used the name "North American" in various ways in connection with airplanes and aviation industry, on tickets, uniforms,

time and fare schedules, at ticket offices and airports in connection with business of buying, selling and reserving airline transportation, and has used the name upon airplanes. It was also pleaded that these actions of defendants were designed, intended and calculated to and did lead to confusion between plaintiffs and others using the name and deceived other persons into believing that a connection existed between plaintiff and organizations fostered by defendants. Defendants denied that plaintiff had any exclusive right to the use of the name "North American" except in the manufacture of aircraft, and denied any appropriation of the benefit of the reputation of plaintiff or that they caused the public to believe a connection existed between plaintiff and defendant.

After a lengthy trial before an experienced judge, Hon. Peirson M. Hall, findings were made in favor of plaintiff on all contentions. A permanent injunction against the use of "North American" by defendants was granted, and damages were awarded to plaintiff. This appeal followed.

It is the principal contention of defendants here that plaintiff did not have and could not acquire an exclusive use of the name "North American" as against others operating in the same geographic area. Especially, it is claimed defendants who operate ticket agencies in connection with air transportation have a right to use the name of the continent in which they do business. It is further urged that, since defendants do not manufacture airplanes for sale to governmental agencies, which defendants claim is the sole business of plaintiff, no injunction should be granted against use of the name in this limited field.

Under a situation where the name "North American" had not been appropriated exclusively in connection with

all phases of aviation by plaintiff for a great number of years without challenge, there might have been some slight basis for the contention that there could be only a limited use of a geographic designation. But the identification of the name with plaintiff in such connection was shown by the evidence to be absolute for a long period of time before defendants began their activities. It is exactly this feature which causes plaintiff to seek relief in the courts. The purposes for which plaintiff was organized, its history as a business concern, the relationship of the public to the activities so conducted and the good will build up in that business are important factors in determining the existence and extent of a secondary meaning of the name of plaintiff.

Plaintiff was organized in December, 1928. Manufacture of airplanes and other aircraft, carrying the mail and operation of air navigation facilities and incidental equipment were its specific objectives. "North American Aviation, Inc." was adopted as its name at that time. This was intended and aptly chosen for the purpose of identifying plaintiff with all phases of aviation. Plaintiff at that time was a holding and management company, owning stock in several companies operating in various phases of aviation. Some subsidiaries ran airlines, others manufactured aircraft and others made electronic equipment. The name "North American" was from the beginning better known generally than the names of the operating companies. Almost from its inception, the stock of North American Aviation, Inc., has been traded on the exchange, and the operating subsidiaries referred to themselves using such terms as "A Division of North American Aviation, Inc." In 1934, plaintiff ceased to be a holding company and

became an operating aviation company with two divisions: (1) manufacturing, (2) air transportation. Plaintiff used the "North American" name in the operation of this air transportation division in that "air transportation activities were conducted under the name of Eastern Air Lines, Division of North American Aviation, Inc., which appeared in time tables which were distributed and available at offices maintained in several cities in the United States, on tickets and baggage checks and stickers issued to passengers, and on various other material used by plaintiff."

Plaintiff has spent a great deal of money in the advertising and publication of the name "North American" and has spent tremendous sums over the years for that purpose. Besides that, owing to the circumstances hereafter mentioned in connection with its activities during the war, plaintiff received a tremendous amount of unpaid publicity. Plaintiff has in this regard used the letters "NAA" together with a symbol or design devised by it, consisting of a triangle enclosing these letters and bearing a formalized drawing of a bird. This symbol was used by plaintiff on airplanes in 1935 and was registered in the United States Patent Office. Plaintiff also used extensively the slogan, "The North American way," since sometime in 1941.

In 1935, plaintiff built a new plant at Los Angeles Airport, which has been greatly expanded during the years and is still its headquarters. In 1938, apparently because of the approaching emergency, plaintiff sold the assets of its air transport division to a new independent corporation known since as "Eastern Airlines." Although plaintiff has not operated a scheduled airline since 1938, for many years it has been operating several airplanes to transport people doing business with it and its own employees.

Irrespective of the fact that its factories were located on the continent, the name of plaintiff had a world wide significance owing to its activities in a war industry. This is so well known that the Court would take judicial notice of it if it had not been proved. But there was exact and explicit proof. Airplanes manufactured by plaintiff and bearing its name were furnished to the government of the United States and flown all over the world. There is testimony to the effect that these planes carried the insignia of North American throughout the world. Defendants cannot avoid this record by pointing out that the advance trainers, of which plaintiff built about sixteen thousand through 1945 and which were the standard airplanes used for advance training of pilots by the United States and thirty-three different countries of the United Nations and of which many are still used throughout the world to train pilots, were popularly denominated "ATS" instead of "North American." The "B-25" or "Mitchell" bomber of "North American" manufacturing was used in the spring of 1942 in the initial raid on Tokyo from Shangri La. These were used throughout the war in the South Pacific and in Europe. Plaintiff built about ten thousand of them. North American P-51, popularly known as the "Mustang," was known at the time as the "most aerodynamically perfect pursuit plane in existence." It was the outstanding fighter of World War II. Sixteen thousand of these were built by plaintiff. These flew over both fronts in World War II. Since the end of World II, plaintiff developed many new types of military aircraft: the North American F-86, "Sabrejet," maintained supremacy of the air for our country in Korea. In view of this, there is no substance to the contention of defendant that, since these aircraft were called popular names the

activities of plaintiff did not strengthen its use of the name "North American."

The proof is irrefutable that "North American" in connection with aviation means the plaintiff solely and exclusively today as well as in the past. The finding of the trial court is that the name had "acquired a secondary meaning, with respect to plaintiff, in connection with airplanes and in the aviation industry. It identified, in connection with airplanes and in the aviation industry, plaintiff and no one else, and was associated, by persons in the aviation industry and by the general public, with plaintiff and no one else." The exclamation of the learned trial judge was only a reflection of the impression which anyone would obtain who impartially read the record:

> "I have never seen, and I cannot imagine, any case where a secondary meaning has become so attached to a party or a business as the words 'North American' have to the plaintiff in this case in the entire aviation industry."

From the record and the findings, the nature of the secondary meaning of "North America" is established as referring to plaintiff alone.

The courts have made the distinction between "strong" and "weak" marks or names. Names "fanciful" in character are denominated "strong." These are designations which are generally not descriptive of the business, the persons involved or the place of business or operation. "Weak" marks are words of common speech and those descriptive of the locality or area where the services are performed or the article used or made. The theory is that generally there cannot be a monopoly of such a

designation.[1] In practical experience, however, where the facts warrant, the courts grant protection even to weak marks or names with varying degrees of limitation.[2] Geographic names which have connotations of the place of use or manufacture are generally subject to use by all persons or concerns who manufacture or operate in the area. Such a name is in the public domain.[3]

The doctrine of secondary meaning is applied as to weak names and particularly as to descriptive or geographic designations. The question of whether a monopoly of such a title has been acquired depends upon its use in relation to goods, business or service to the point where the public identifies the name with a particular individual or entity. It is extremely difficult to give to a geographic term a proprietary connotation since under ordinary circumstances it cannot be used to exclude others who operate

---

[1]"Generic terms and words descriptive of place are not subject to exclusive appropriation. * * * The plaintiff points out, however, that it has not formulated its case on the claim of technical trade-mark or exclusive right. Its cause of action is based on the distinctive or secondary meaning which its name has acquired and on the unfair and deceptive use of that meaning which it is alleged the defendant has made and threatens to continue to make, to the damage of the plaintiff in particular and the confusion and deceit in relation to the public generally." Academy of Motion Picture Arts & Sciences v. Benson, 15 California 2d 685, 688.

[2]"The proprietary connotation,—'secondary meaning,'—of a word of common speech is harder to create and easier to lose, and its fringe or penumbra does not usually extend so far as that of a coined word. But that is a matter of proof and of that alone * * * It would therefore be wrong to make an absolute distinction between coined, and colloquial, names." Landers, Frary & Clark v. Universal Cooler Corporation, 2 Cir., 85 F. 2d 46, 48.

[3]Phillips v. The Governor and Company of Adventurers of England Trading into Hudson's Bay, 9 Cir., 79 F. 2d 971. For similar fact situations, see Academy of Motion Picture Arts & Sciences v. Benson, 15 California 2d 685; British-American Tobacco Co., Ltd. v. British-American Cigar Stores Co., 2 Cir., 211 Fed. 933; Continental Distilling Sales Co. v. Brancato, 8 Cir., 173 F. 2d 296.

in the same area, as above noted. But this does not mean that a name of territorial origin may not acquire a secondary or fanciful meaning connected. When this occurs, the proprietorship in the designation or mark will be afforded as complete protection as if it were a "strong" mark at the inception.

In Phillips v. The Governor and Company of Adventurers of England Trading into Hudson's Bay, 9 Cir., 79 F. 2d 971, this Court held that plaintiff corporation, commonly known as "Hudson's Bay Company," whose charter was granted by Charles II of England, was entitled to an injunction against a person using the name "Hudson Bay Fur Company" in Nevada. The facts (1) that the word "fur" did not occur in the title of plaintiffs; (2) that plaintiffs had ceased doing business in the United States and therefore was not a competitor in the retail fur business; (3) that the name was geographical in origin, and (4) that it was descriptive in character, did not militate against its monopolistic appropriation by plaintiff as applied to trade in fur. The rationale of this decision is aptly set out in another opinion, where it is said that the company's "position before the public has been altogether unique and the name Hudson Bay, although territorial in its significance, has long been definitely identified in an unusually exclusive way with the plaintiff."[4]

The question of whether a name used by a person in any line of activity has taken on a secondary or fanciful meaning identified with the activity and the person engaging therein is one of fact. The trial court found plaintiff

---

[4]The Governor and Company of Adventurers of England Trading into Hudson's Bay v. Hudson Bay Fur Co. (D. C.), 33 F. 2d 801.

had adopted the name "North American" to identify it with all phases of aviation industry, specifically including air transportation, and that no one else had presumed to use the name up until 1948 in any connection relating to aviation. This connection was not dissipated by the fact that plaintiff for some years has not engaged commercially in air transportation except for limited purposes. Based upon a review of the evidence, we hold these findings of fact are proper and firmly founded. A contrary finding would have been set aside as clearly erroneous. If it were our function, this Court would enter findings which would in substance be identical.

Inherent in these findings it is established beyond dispute that "North American" has acquired a fanciful meaning connected with plaintiff. This world wide use of these products, made in factories under this name and bearing this name throughout the world in a distinguished performance which led to the supremacy of the United States in aerial warfare, changed the content of the name "North America" in connection with any phase of aviation and gave it a secondary significance and a fantastic meaning, so that it was identified not with any activities on the North American continent, but within the airways and aerial fighting fields of the world as indicating plaintiff and plaintiff alone. Its celebrity is attested in Tokyo, Berlin and Seoul, the mystic isles of the South Seas, and perhaps on the Volga. "North American" had a comparable relation to aviation over the world which the "Governor and Company of Adventurers of England Trading into Hudson's Bay" had to fur. "Hudson's Bay" means fur all over the world. "North American" means all activities connected with aviation in the same area. The reputation of plaintiff in all activities with regard to aviation is char-

acterized by universality. The designation has been given a secondary significance by the distinguished attainments of its possessor, of which all the world knows. Since this is a diversity case, the law of California is of considerable importance. This doctrine that a name geographical in origin can be monopolized by an individual in connection with particular activities is firmly established there:

> "Where words have acquired, as is established beyond dispute in this case, a fanciful meaning—a meaning that has no connection with their common meaning, it may be more properly said that such meaning is their primary meaning in so far as their use in business is concerned. Their common meaning has dropped into the background. Otherwise no right to use them to the exclusion of others would have been acquired. When, however, words have acquired such a sense and are the subject of the good will and reputation of a business which they designate, there is little if anything left to distinguish them from a trademark, a symbol, characters or words which have no common meaning and which are artificial, in so far as the scope of protection afforded to the one who has the prior right."[5]

Defendants urge that, even though it was found that they were taking a "free ride upon the good will and reputation built up by the plaintiff," no sufficient basis for relief of plaintiff is thereby established. So far, therefore, we have dealt with the case without reference to the activities of defendant. We have found now that the evidence as well as the findings firmly establish North American Aviation, Inc., as the possession of plaintiff and that it has acquired not only a secondary significance, but, on

---

[5]Eastern-Columbia, Inc. v. Waldman, 30 Cal. 2d 268, 271.

account of the events of recent history, is "fanciful" in its designation of plaintiff in all fields connected with transportation by air and aviation.

It may be remarked in passing that there is no rule that knowing and unauthorized appropriation of the name by defendants is not a factor for consideration in determining whether the rights of plaintiff have been infringed. "These two considerations, the length of user and the fraud, are enough evidence of secondary meaning to support an injunction." American Medicinal Spirits Co. v. United Distillers, Ltd., 2 Cir., 76 F. 2d 124, 125.

Therefore, we now turn to the activities of defendants. Defendants began to use the name about 1950. They bought out a small private airline that had begun using the name in 1949. It will be noted that plaintiff's property in the name was by that time fully and exclusively developed, not only as against defendants, but against the world. Defendants' claim is that the exclusive use of the name by plaintiff must be confined to the manufacture of airplanes and that the name cannot be used exclusively in the air transportation field. Thus they claim that they are not in competition with plaintiff. Under the authorities, competition is not a condition precedent to the granting of an injunction.[6]

But the evidence shows that the use by defendants of the name placed them in direct competition with plaintiff. The evidence shows pictures of airplanes, manufactured

---

[6]Phillips v. The Governor and Company of Adventurers of England Trading into Hudson's Bay, 9 Cir., 79 F. 2d 971.

Now there must be added to these facts that plaintiff has not attempted to monopolize the name "North American" in alien fields such as storage and truck transportation and others. The field of aviation has been invaded by defendants under cover of this name.

by competitors of plaintiff, which have emblazoned in large letters almost the full length of the fusilage the words "North American."[7] Although these airplanes of other manufacturers are not sold under that name, it is an appropriation of the property of plaintiff to permit use of such airplanes under this designation. The public are not required to determine whether the "North American" so prominently displayed describes the manufacturer of the airplane or the ticket broker who sells transportation thereon. This is a direct competition. Added to that, defendants have appropriated the slogan, "Fly the North American Way," which had a peculiar connotation connected with airplanes manufactured by plaintiff because of its use for many years in that connection in peace and in war. Defendants have relied upon the good will and reputation of plaintiff to build up their business. They have spent money freely and in tremendous sums to encourage the belief that they were plaintiff.

The use by defendants in this connection of a copy of the stylized design which plaintiff had invented, varying the design only enough to permit defendants to hope that it would encourage the public to believe defendants were plaintiff but enough to confuse judges into the belief that defendants are in good faith. It is conclusive evidence that defendants were doing all they could to identify themselves with plaintiff and capitalize on the reputation which plaintiff had built up under this exclusive name. But, of course, that does not permit them to take away plaintiff's

---

[7]This fact alone would be sufficient to distinguish this case from previous cases in this Court. Sunbeam Lighting Co. v. Sunbeam Corporation, 183 F. 2d 969; Sunbeam Furniture Corporation v. Sunbeam Corporation, 191 F. 2d 141.

right to operate under the name "North American" in the transport field with airplanes which it manufactures or license the use thereof by others. Plaintiff is not required to see aircraft manufactured by a competitor flown under the protection of a name which it has exclusively built up. Defendants have no right to dispute this market under the name "North American," as they are now attempting to do. Notwithstanding the disclaimer of plaintiff of the role of a "vicarious champion of the public," it is the opinion of this Court that the public has a vital interest in preventing confusion of the name of plaintiff.[8] The direct customers of plaintiff are at present governments and governmental agencies. But conditions may change.

The attempt of defendants to prevent plaintiff from in the future engaging in air transport, which was one of the purposes for which it was organized and in which field it had an honorable history, is quite improper and one which plaintiff had a right to resist.

North American Aircoach Systems, Inc., is nothing but a ticket drummer. Therefore, in advertising itself as "North American Airlines," it is not only appropriating from plaintiff, but it is also falsely describing itself to the public. Defendant "Twentieth Century," whose airplanes have been prominently marked "North American," did not actually change its name to "North American" until after this action was commenced. Defendants maintain their principal facility at Los Angeles in connection

---

[8]See American Philatelic Society v. Claibourne, 3 California 2d 689, 698, where it is said: "It is also to be borne in mind that the rules of unfair competition are based not alone upon the protection of a property right existing in the complainants, but also upon the right of the public to protection from fraud and deceit."

with a manufacturer of airplanes in competition with plaintiff. It is of no small consequence that plaintiff for many years before defendants invaded the field has had its headquarters and principal manufacturing plant also in Los Angeles. Defendants have pursued their course persistently, and have entirely disregarded all warnings. They were notified by plaintiff of violation in 1950 and 1951. The California Board refused to allow the registration of the corporate name of "North American Aircoach Systems, Inc.," because of the conflict with the long previously registered name of plaintiff. Defendants urge that their adoption of the name is justified by the advice of an attorney. A prerequisite to validity of such a defense is that the situation be characterized by good faith on both parts.

There was overwhelming proof of confusion of source. Instances of actual confusion in the mind of the public were stacked high in the record. The trial court found the acts of defendants were designed, intended and calculated to cause confusion and "have already misled numerous members of the general public including persons desiring to obtain air transportation or otherwise have dealings with defendants, into believing, contrary to fact, that plaintiff, or a subsidiary or branch of plaintiff under plaintiff's control and supervision, conducts defendants' businesses and operations, and that a connection exists between plaintiff, its business and operations, and defendants, their businesses and operations; and that defendants are either a part of plaintiff's organization or in some way controlled by plaintiff." When such an appropriation is coupled with representations that North American Airlines is a single air carrier or entity which, as an operating carrier, has flown a billion passenger

miles without an accident and that half a million passengers, have placed confidence in it as one of the four great airlines, the injury to plaintiff and the public is apparent. Under such circumstances, the public was in need of a champion. But plaintiff had its own vital interest to protect. Furthermore, the record shows that the activities of defendants have been such that shades might have been cast upon the reputation of plaintiff if it had not been so well established.

There is then no basis for the contention of defendants that the field covered by the name has been limited as to plaintiff so that ticket selling for serial transportation can be carried on by alien interests appropriating plaintiff's name and displaying "North American" prominently upon airplanes which it did not manufacture.

Against this background, an appraisal must be made of the plea of defendants that the injunction was too broad. Here there must be a résumé of the motive and intent of defendants. The record is replete with evidence of a bold intentional and illegal seizure of the name of plaintiff. It is the duty of the courts to prevent such practice through the use of the extraordinary writ of injunction. Even if the injunction be now placed in effect, defendants have made gains which can never be taken away from them, and plaintiff has suffered intangible losses which can never be repaired. Defendants are asking the grace of the chancellor when they ask for this amelioration of the terms of the injunction. But the hands they stretch out in prayer are unclean.

The judgment is affirmed.

(Endorsed:) Opinion. Filed Sep. 28, 1955.

Paul P. O'Brien, Clerk.

Supreme Court, U.S.
FILED
FEB 20 1956
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

October Term, 1955

No. 658

NORTH AMERICAN AIRCOACH SYSTEMS, INC. (also known as NORTH AMERICAN AIRLINES AGENCY CORP., and NORTH AMERICA AIRLINES AGENCY CORP.), TWENTIETH CENTURY AIR LINES, INCORPORATED, JAMES FISCHGRUND, JACK B. LEWIN and STANLEY D. WEISS,

Petitioners,

v.

NORTH AMERICAN AVIATION, INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

CHARLES PICKETT,
25 Broadway,
New York 4, N. Y.

and

EDWARD L. COMPTON,
ARCH R. TUTHILL,
458 South Spring Street,
Los Angeles 13, California,

Attorneys for Respondent.

CHADBOURNE, PARKE, WHITESIDE & WOLFF,
25 Broadway,
New York 4, N. Y.

and

FLINT & MACKAY,
458 South Spring Street,
Los Angeles 13, California,
of Counsel.

INDEX

PAGE

No Reason Exists to Invoke This Court's Jurisdiction 1

Opinions Below 3

Question Presented 3

Statement of the Case 4

The Secondary Meaning Which Plaintiff Achieved in the "North American" Name 4

Plaintiff and Its Outstanding Reputation 5

Plaintiff's Activities in Aviation 6

Defendants' Fraudulent Appropriation of the "North American" Name 8

Defendants' Fraudulent Uses of the "North American" Name 9

Argument 11

I. The Decision Below Accords With, and Does Not Conflict With, This Court's Decisions 11

II. The "Direct Conflict" Which Petitioners Profess to Find With Other Decisions Is Imaginary 15

A. The Non-Existent "Conflict" With Earlier Decisions in the Ninth Circuit 15

B. The Non-Existent "Conflict" With a California Case 17

PAGE

C. The Non-Existent "Conflict" With Cases in Other Circuits 18

III. There Is No Conflict Whatever Between the Decision Below and the Civil Aeronautics Board Case Against One of the Petitioners 19

A. The Legal Issues in the Two Cases Are Entirely Different 20

B. The Two Cases Are Factually As Well As Legally Different 21

C. Repeatedly the Court of Appeals for the District of Columbia Circuit Pointed Out the Inapplicability of Its Decision to Private Litigation 22

IV. The Suggestion That the Civil Aeronautics Board Case Will Become Moot, If Certiorari Is Denied Here, Is Irrelevant and Incorrect 23

CONCLUSION 25

APPENDIX A: Cases Protecting Geographical Names Which Had Acquired a Secondary Meaning i

APPENDIX B: Cases Protecting Marks or Names Against Non-Competitive Use Where Confusion of Source Was Likely iv

TABLE OF AUTHORITIES CITED

Cases

PAGE

Academy of Motion Picture Arts and Sciences v. Benson, 15 Cal. 2d 685, 104 P. 2d 650 ..... 17, v*

Admiral Corp. v. Penco, Inc., 203 F. 2d 517 ix

Akron-Overland Tire Co. v. Willys-Overland Co., 273 Fed. 674 vi

Albany Packing Co., Inc. v. Crispo, 227 App. Div. 591, 237 N. Y. Supp. 614, affd. 253 N. Y. 607, 171 N. E. 803 ix

Alfred Dunhill of London, Inc. v. Dunhill Shirt Shop, Inc., 3 F. Supp. 487 vii

Amalgamated Utility Workers (C. I. O.) v. Consolidated Edison Co. of New York, 309 U. S. 261 20

American Automobile Assn. v. American Automobile Owners' Assn., 216 Cal. 125, 13 P. 2d 707 17

American Automobile Ins. Co. v. American Auto Club, 184 F. 2d 407 15-16

American Chicle Co. v. Topps Chewing Gum, Inc., 208 F. 2d 560 22

American Clay Mfg. Co. v. American Clay Mfg. Co. of New Jersey, 198 Pa. 189, 47 Atl. 936 ii

American Distilling Co. v. Bellows & Co., 102 Cal. App. 2d 8, 226 P. 2d 751 17

American Home Benefit Assn., Inc. v. United American Benefit Assn., Inc., 63 Idaho 754, 125 P. 2d 1010 ii

American Insulation Co. v. Eternit Roofing Corp., 14 F. 2d 235 ix

* References to Roman numerals indicate pages in the Appendices.

PAGE

American Oil Co. v. Norkus, 358 Pa. 407, 57 A. 2d 868 — ii

American Products Co. v. American Products Co., 42 F. 2d 488 — iv

American Radio Stores, Inc. v. American Radio & Television Stores Corp., 17 Del. Ch. 127, 150 Atl. 180 — ii

American Shops, Inc. v. American Fashion Shops of Journal Square, Inc., 13 N. J. Super. 416, 80 A. 2d 575, cert. den. 7 N. J. 576, 83 A. 2d 379 — ii

American Thread Co. v. North American Thread Co., Inc., 33 F. Supp. 616 — i

Armour & Co. v. Armour Shipping Corp., 175 Misc. 695, 25 N. Y. S. 2d 47 — viii

Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U. S. 315 — 12

Arthur Guinness, Son & Co. v. Oscar Von Bernuth, Inc., 14 F. Supp. 210 — v

Avrick v. Rockmont Envelope Co., 155 F. 2d 568 — 22

Baglin v. Cusenier Co., 221 U. S. 580 — 13

Benioff v. Benioff, 64 Cal. App. 745, 222 Pac. 835 — i

Bernstein v. Friedman, 62 Wyo. 16, 160 P. 2d 227 — iii

Bradford Baking Co. v. Weber Baking Co., 43 Cal. App. 570, 185 Pac. 417 — i

British-American Tobacco Co., Ltd. v. British-American Cigar Stores Co., 211 Fed. 933 — iv

Brooks Bros. v. Brooks Clothing of California, Ltd., 60 F. Supp. 442, affd. 158 F. 2d 798, cert. den. 331 U. S. 824 — x

Brown v. Hook, 79 Cal. App. 2d 781, 180 P. 2d 982 — 17

PAGE

Buckspan v. Hudson's Bay Co., 22 F. 2d 721, cert. den. 276 U. S. 628 iv

Cady v. Schultz, 19 R. I. 193, 32 Atl. 915 iii

California Prune & Apricot Growers Assn. v. H. R. Nicholson Co., 69 Cal. App. 2d 207, 158 P. 2d 764 ... viii

Canal Co. v. Clark, 13 Wall. 311 14

Carolina Pines, Inc. v. Catalina Pines, 128 Cal. App. 84, 16 P. 2d 781 i

Churchill Downs Distilling Co. v. Churchill Downs, Inc., 262 Ky. 567, 90 S. W. 2d 1041 v

Cleo Syrup Corp. v. Coca-Cola Co., 139 F. 2d 416, cert. den. 321 U. S. 781 22

Coca-Cola Co. v. Koke Co. of America, 254 U. S. 143 ... 12

Cole of California, Inc. v. Grayson Shops, Inc., 72 Cal. App. 2d 772, 165 P. 2d 963 ix

Colorado National Co. v. Colorado National Bank of Denver, 95 Colo. 386, 36 P. 2d 454 v

Columbia Broadcasting System, Inc. v. Columbia of New York, Inc., 97 N. Y. S. 2d 455, affd. 277 App. Div. 856, 98 N. Y. S. 2d 384 v

Columbia Mill Co. v. Alcorn, 150 U. S. 460 14

Conde Nast Publications, Inc. v. Vogue School of Fashion Modelling, Inc., 105 F. Supp. 325 vi

Continental Distilling Sales Co. v. Brancato, 173 F. 2d 296 ii

Del Monte Special Food Co. v. California Packing Corp., 34 F. 2d 774 iv

Duro Co. v. Duro Co., 27 F. 2d 339 ix

PAGE

E. I. DuPont de Nemours & Co. v. DuPont Safety Razor Corp., 82 A. 2d 384 ——— viii

E. Kahn's Sons Co. v. Columbus Packing Co., 82 F. 2d 897 ——— 22

Eastern Columbia, Inc. v. Waldman, 30 Cal. 2d 268, 181 P. 2d 865 ——— i

Elder Mfg. Co. v. Martin Trenkle Co., 90 F. Supp. 889 ——— vii

Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665 ——— 11, 12, 15

Esquire, Inc. v. Maira, 101 F. Supp. 398 ——— ix

Federal Trade Comm. v. Klesner, 280 U. S. 19 ——— 21

Fisher v. Star Co., 231 N. Y. 414, 132 N. E. 133, cert. den. 257 U. S. 654 ——— 20

Florence Mfg. Co. v. J. C. Dowd & Co., 178 Fed. 73 ——— v

Ford Motor Co. v. Benjamin E. Boone, Inc., 244 Fed. 335 ——— vi

Ford Motor Co. v. Ford Insecticide Corp., 69 F. Supp. 935 ——— vii

French Republic v. Saratoga Vichy Co., 191 U. S. 427 ——— 12

German-American Button Co. v. A. Heymsfeld, Inc., 170 App. Div. 416, 156 N. Y. Supp. 223 ——— ii

Golden Slipper Square Club v. Golden Slipper Restaurant & Catering, Inc., 371 Pa. 92, 88 A. 2d 734 ——— x

Governor and Company of Adventurers of England Trading Into Hudson's Bay v. Hudson Bay Fur Co., 33 F. 2d 801 ——— iv

H. Moffat Co. v. Koftinow, 104 Cal. App. 2d 560, 232 P. 2d 15 ——— i

Hamilton-Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 251 ——— 13, 15

PAGE

Hanson v. Triangle Publications, Inc., 163 F. 2d 74, cert. den. 332 U. S. 855 ix

Horlick's Malted Milk Corp. v. Horluck's Inc., 59 F. 2d 13 vi

Hotels Statler Co. Inc. v. Chase, 104 F. Supp. 533 viii

Hoyt Heater Co. v. Hoyt, 68 Cal. App. 2d 523, 157 P. 2d 657 17

Hudson Motor Car Co. v. Hudson Tire Co., 21 F. 2d 453 iv

Indian Territory Oil & Gas Co. v. Indian Territory Illuminating Oil Co., 95 F. 2d 711, cert. den. 305 U. S. 607 iv

Jackman v. Mau, 78 Cal. App. 2d 234, 177 P. 2d 599 vii

Jackson v. Universal International Pictures, Inc., 36 Cal. 2d 116, 222 P. 2d 433 17

Jewel Tea Co., Inc. v. Kraus, 187 F. 2d 278 ix

Kay Jewelry Co. v. Kapiloff, 204 Ga. 209, 49 S. E. 2d 19 viii

L. E. Waterman Co. v. Gordon, 72 F. 2d 272 vii

Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537 13

Libby, McNeill & Libby v. Libby, 103 F. Supp. 968 vii

Lincoln Motor Co. v. Lincoln Automobile Co., 44 F. 2d 812 vii

Lutz v. Western Iron & Metal Co., 190 Cal. 554, 213 Pac. 962 i

MacSweeney Enterprises, Inc. v. Tarantino, 106 Cal. App. 2d 504, 235 P. 2d 266 vii

Mantle Lamp Co. of America v. Aladdin Mfg. Co., 78 F. 2d 426, cert. den. 296 U. S. 639 ix

PAGE

Martha Washington Candies Co., Inc. v. Martha Washington Ice Cream Co., Inc., 280 App. Div. 256, 113 N. Y. S. 2d 119, app. dismissed, 304 N. Y. 974, 110 N. E. 2d 896 ——— viii

Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc., 221 F. 2d 464, cert. den. 350 U. S. 832 ——— 22

McGraw-Hill Publishing Co. v. American Aviation Associates, Inc., 117 F. 2d 293 ——— 18-19

Metropolitan Opera Assn., Inc. v. Metropolitan Opera Assn. of Chicago, Inc., 81 F. Supp. 127 ——— vi

Metropolitan Opera Assn., Inc. v. Pilot Radio Corp., 189 Misc. 505, 68 N. Y. S. 2d 789 ——— vi

Milani v. Smith, 85 Cal. App. 2d 163, 192 P. 2d 830 ——— 17

Mills v. San Diego Conservatory of Music, 47 Cal. App. 300, 191 Pac. 546 ——— i

Moore v. New York Cotton Exchange, 270 U. S. 593 ——— 20

My-T Fine Corp. v. Samuels, 69 F. 2d 76 ——— 22

National Lead Co. v. Wolfe, 223 F. 2d 195, cert. den. 350 U. S. 883 ——— 22

National Tool Salvage Co. v. National Tool Salvage Industries, Inc., 186 Misc. 833, 60 N. Y. S. 2d 308 ——— ii

North American Airlines, Inc. v. Civil Aeronautics Board, unreported (D. C. Cir., June 23, 1955) ——— 19-25

Northern Metal Co. v. Maier, 337 Pa. 257, 11 A. 2d 140 ii

Northmont Hosiery Corp. v. True Mfg. Co., 100 F. Supp. 909 ——— ix

Northwest Ready Roofing Co. v. Antes, 117 Neb. 121, 219 N. W. 848 ——— iii

Northwestern Knitting Co. v. Garon, 112 Minn. 321, 128 N. W. 288 ——— v

PAGE

Olin Mathieson Chemical Corp. v. Western States Cutlery & Mfg. Co., 227 F. 2d 728 ____ 19

Philad Co. v. Murray's Beauty Salon, 14 F. Supp. 626, app. dismissed, 96 F. 2d 1019 ____ vi

Phillips v. Governor & Company of Adventurers of England Trading Into Hudson's Bay, 79 F. 2d 971 ____ iv

Pohl v. Anderson, 13 Cal. App. 2d 241, 56 P. 2d 992 ____ 17

Premier Cycle Co., Ltd. v. Premier Tube Co., Ltd., 12 T. L. R. 481 ____ x

Pro-phy-lac-tic Brush Co. v. Abraham & Straus, Inc., 11 F. Supp. 660 ____ vi

Rosenberg v. Rosenthal, 135 Misc. 282, 238 N. Y. Supp. 62 ____ ii

Rosenthal v. Brasley-Krieger Shoe Co., Ltd., 19 Cal. App. 2d 257, 64 P. 2d 1109 ____ 17

Safeway Stores, Inc. v. Dunnell, 172 F. 2d 649 ____ viii

Samson Crane Co. v. Union Nat. Sales, Inc., 87 F. Supp. 218, affd. 180 F. 2d 896 ____ 20

Schwartz v. Slenderella Systems of California, Inc., 43 Cal. 2d 107, 271 P. 2d 857 ____ x

Shaver v. Heller & Merz Co., 108 Fed. 821 ____ 13, i

Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169 ____ 12

Socony-Vacuum Oil Co., Inc. v. Lafariere, 48 N. Y. S. 2d 421 ____ vi

Stork Restaurant, Inc. v. Sahati, 166 F. 2d 348 ____ x

Straus v. Notaseme Hosiery Co., 240 U. S. 179 ____ 12

Sunbeam Furniture Corp. v. Sunbeam Corp., 191 F. 2d 141, rehearing denied, 191 F. 2d 731 ____ x

PAGE

Tiffany & Co. v. Tiffany Productions, Inc., 147 Misc. 679, 264 N. Y. Supp. 459, affd. 237 App. Div. 801, 260 N. Y. Supp. 821, affd. 262 N. Y. 482, 188 N. E. 30 _ viii

Triangle Publications, Inc. v. Rohrlich, 167 F. 2d 969 _ 22, ix

United States v. Borden Co., 347 U. S. 514 _____ 24

United States Light & Heating Co. of Maine v. United States Light & Heating Co. of New York, 181 Fed. 182 _____ iii

United States Ozone Co. v. United States Ozone Company of America, 62 F. 2d 881 _____ iii

Walter v. Ashton, (1902) 2 Ch. 282 _____ x

Warner & Co. v. Eli Lilly & Co., 265 U. S. 526 _____ 11

Wayne County Produce Co. v. Gordon-O'Neill Co., Inc., 249 App. Div. 743, 291 N. Y. Supp. 641, affd. 274 N. Y. 556, 10 N. E. 2d 549 _____ v

Western Auto Supply Co. v. Knox, 93 F. 2d 850 ____ iii

Winfield v. Charles, 77 Cal. App. 2d 64, 175 P. 2d 69 __ vii

Wisconsin Electric Co. v. Dumore Co., 282 U. S. 813 __ 3

Yale Electric Corp. v. Robertson, 26 F. 2d 972 _____ vii

STATUTE

United States Code Annotated, Title 49, Sec. 491 (Civil Aeronautics Act, Sec. 411) _____ 20-21

RULE

Rule 19, par. 1, of Rules of the Supreme Court of the United States _____ 3

IN THE

Supreme Court of the United States

October Term, 1955

No. 658

NORTH AMERICAN AIRCOACH SYSTEMS, INC. (also known as NORTH AMERICAN AIRLINES AGENCY CORP., and NORTH AMERICA AIRLINES AGENCY CORP.), TWENTIETH CENTURY AIR LINES, INCORPORATED, JAMES FISCHGRUND, JACK B. LEWIN and STANLEY D. WEISS,

Petitioners,

v.

NORTH AMERICAN AVIATION, INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Petitioners seek review of a judgment of the United States Court of Appeals for the Ninth Circuit which unanimously affirmed a judgment enjoining petitioners' fraudulent appropriation of plaintiff's celebrated trade name "North American." All parties do business in California, but there is diversity of citizenship.

No Reason Exists to Invoke This Court's Jurisdiction

No constitutional or Federal question is involved. No important question of local law is presented. The decision

is based on the application of settled legal principles to the particular facts established below.

Those facts show a case of flagrant fraud, denounced by the District Judge and the Court of Appeals.

Long before defendants took plaintiff's name "North American," it had acquired "a secondary meaning, with respect to plaintiff, in connection with airplanes and in the aviation industry" [F 25(d), I 64].*

Then defendants misappropriated that name. "The record," as the Court of Appeals remarked, "is replete with evidence of a bold, intentional and illegal seizure of the name of plaintiff" (CA 12).** Defendants' seizure of the name was "designed, intended and calculated to cause confusion of source between plaintiff and defendants" [F 61, I 79]. And the court found [F 64, I 84-85]:

> "Defendants' uses of the name 'North American' were designed, intended and calculated to, and have resulted in, the deception, confusion and injury of the public. *Defendants did not use the name 'North American' innocently or in good faith, but deliberately and fraudulently.*"***

---

* Numbers in brackets refer to the volume and page of the printed transcript of record. When preceded by "F," they refer to the findings of fact. Thus the quotation above is from Finding 25(d), printed in volume I of the transcript at page 64. Exhibits have not been printed and therefore are identified only by number or letter.

** References preceded by "CA" are to the pages of the slip opinion of the Court of Appeals in this case.

*** Italics are ours throughout unless otherwise stated.

The court therefore enjoined defendants' deceptive use of a name which has actually caused the widespread public confusion that defendants fraudulently sought to promote [F 62, I 80-81].

The decision below rests on the individual facts of this particular case. Quite imaginary is the asserted "conflict" in decisions which defendants struggle to fabricate. As this Court pointed out when dismissing "as improvidently granted" a writ of certiorari in another unfair competition case of the same general type, "the asserted conflict in decisions arises from differences in states of fact, and not in the application of a principle of law . . ." *Wisconsin Electric Co.* v. *Dumore Co.*, 282 U. S. 813.

"A review on writ of certiorari . . . will be granted only where there are *special* and *important* reasons therefor." Rule 19, par. 1. Here there is no reason for granting the writ—much less a "special" or "important" reason.

Opinions Below

An oral opinion was delivered by the District Judge at the end of the trial [IV 2012-2020]. The opinion of the Court of Appeals is reported in 107 USPQ 68.

Question Presented

Only one question is presented:

After the name "North American" had been used exclusively by plaintiff in all phases of the aviation industry for over twenty years, and as a result of plaintiff's efforts and achievements had acquired a secondary meaning iden-

tifying plaintiff to the public in connection with airplanes and aviation, may defendants fraudulently use that name in connection with airplanes with the purpose and effect of deceiving the public into believing that plaintiff operates, sponsors or is otherwise connected with defendants' aviation enterprise?

Statement of the Case

The all-important facts, which petitioners state inaccurately and inadequately, are set out in the findings [I 51-86]. The Court of Appeals summarized them forcefully (CA 3-5, 7-8, 9-12). Here they need only be sketched.

The Secondary Meaning Which Plaintiff Achieved in the "North American" Name

Years before defendants appropriated plaintiff's "North American" name, it had already "acquired a secondary meaning, with respect to plaintiff, in connection with airplanes and in the aviation industry. It identified, in connection with airplanes and in the aviation industry, plaintiff and no one else, and was associated, by persons in the aviation industry and by the general public, with plaintiff and no one else" [F 25(d), I 64].

Approving this finding, the Court of Appeals said (CA 5):

> "The proof is irrefutable that 'North American' in connection with aviation means the plaintiff solely and exclusively today as well as in the past."

It endorsed, as "a reflection of the impression which anyone would obtain who impartially read the record"

(*ibid.*), the trial judge's remark at the close of the case [IV 2014]:

> "I have never seen, and I cannot imagine, any case where a secondary meaning has become so attached to a party or a business as the words 'North American' have to the plaintiff in this case in the entire aviation industry."

Plaintiff and Its Outstanding Reputation

Plaintiff was organized in 1928. Its name, North American *Aviation,* Inc., was aptly chosen to identify it with all phases of the aviation industry [F 1, I 51].

Plaintiff has spent a fortune to advertise and publicize its "North American" name by all sorts of media—newspapers, magazines, motion pictures, model airplanes and so on [F 19, I 60-61]. Over $2,000,000 had been spent before any defendant used the name [F 22, I 62].

In addition, plaintiff has "received a tremendous amount of unpaid publicity, in which it was frequently referred to simply as 'North American'" [F 23, I 62; see also, F 15, I 56-57].

In 1951, defendants' attorney admitted [Ex. 265]:

> "The statement contained in your letter that *the experience of your company in aviation has been one of continued success* cannot be denied, and it is acknowledged that *your company has an outstanding reputation throughout the world* as a manufacturer of aircraft."

The trial court so found [F 25(a) and (b), I 63-64].

Plaintiff's Activities in Aviation

1. Until the end of 1934 plaintiff owned several operating subsidiaries, such as Eastern Air, TWA, General Aviation and Sperry, which ran airlines, built aircraft and made electronic equipment [F 2-4, I 51-53].

The subsidiaries used such terms as "A Division of North American Aviation, Inc." in their advertisements and otherwise [F 5, I 53]. Even in those days, "North American" was better known than the names of the operating companies [I 138-139]. Newspaper and magazine articles referred to plaintiff simply as "North American" [F 5, I 53]; *e.g.*, "*North American's* Air Lines Which Fly About 40,000 Miles Daily" [I 136; Ex. 14].

2. At the end of 1934 plaintiff became an operating aviation company with a manufacturing division and an air transportation division [F 6-7, I 53]. Its "air transportation activities were conducted under the name Eastern Air Lines, Division of North American Aviation, Inc., which appeared in time tables . . . tickets . . . and on various other material used by plaintiff" [F 8, I 54].

In 1938, with war imminent, plaintiff sold the assets of its Eastern Air Lines division in order to expand into "the manufacturing side of the picture" [I 458]. For many years, however, it has been operating several airplanes to transport people doing business with it [F 9, I 54].

3. From 1938 to the end of World War II, plaintiff's activities centered around three renowned airplanes.

The "Mustang" or P-51 "was the outstanding fighter airplane of World War II" [F 16(b), I 57]. As the 1943

Truman Committee Report said, the "North American P-51, popularly known as the Mustang . . . has been characterized by both the British and the American air forces as the most aerodynamically perfect pursuit plane in existence" [I 297; Ex. 89, pp. 8-9].

The B-25 or "Mitchell" medium bomber, which came into national prominence in the first bombing of Tokyo in 1942, "was the mainstay of air operations in the South Pacific during World War II and was also employed in the European theater" [F 16(c), I 57-58].

The AT-6 "was the standard airplane used for the advanced training of pilots during World War II, being used by the United States Army, Navy and Marine Corps and by 33 different countries of the United Nations" [F 16(a), I 57].

4. After V-J Day, plaintiff built a four-place civilian airplane which it advertised and sold until September 1947. Since the cold war began, plaintiff has not built any more civilian aircraft, but it still maintains a staff studying commercial airplane developments [F 18(a), I 59].

5. Probably the most celebrated of plaintiff's post-war airplanes is the jet fighter, the F-86 or "Sabre." Of it, the Air Force said that "the North American F-86 Sabrejet has distinguished itself in Korea as the principal United Nations' plane to accept and throw back the challenge offered by the MIG-15 to our superiority over the battlefield" [Ex. 139, I 436; and see F 17, I 58].

6. In the post-war years, plaintiff has also engaged in other phases of aviation—the development of guided missiles, the utilization of atomic energy, and the produc-

tion of electronic devices used largely on or with aircraft [F 18(b) and (c), I 59-60].

In short, plaintiff has kept its business fluid [F 18(d), I 60]—and its business is "anything that has to do with aviation" [I 435], "the aviation business and all of its fields" [II 520].

Defendants' Fraudulent Appropriation of the "North American" Name

For years the individual defendants were engaged in operating so-called non-scheduled airlines under several names other than "North American" [F 28-34, I 65-67]. Indeed, until defendants began to use that name, plaintiff alone had used "North American" in connection with airplanes or in the aviation industry, with two inconsequential exceptions [F 24, I 63].

In February 1950, the individual defendants began a new venture: a ticket agency to procure passengers for non-scheduled air carriers. "They were already using a number of names for such ticket agencies, but they rejected them as well as many other names . . ." [F 39, I 68-69].

The individual defendants knew, of course, of plaintiff's use and popularization of the "North American" name. They "intended to . . . capitalize upon and secure to themselves the reputation of plaintiff and its good will, and the value and reputation which the name 'North American' had acquired" in the aviation industry [F 26, I 64]. Therefore they took the name "North American" for their new corporation, defendant North American Aircoach Systems, Inc. [F 39, I 68-69].

Defendants' Fraudulent Uses of the "North American" Name

To trace in full the findings as to defendants' machinations, and their misuses of the "North American" name, would extend this brief unduly [F 40-64, I 69-85]. A few points may be noted.

1. The parties use the same name, in the same industry, in connection with the same type of article—airplanes. "Plaintiff and defendants have been and are using the name 'North American' in the aviation industry" [F 59, I 77] and "in very closely related and allied businesses" [F 60, I 78].

2. While defendants' organization comprises a complicated congeries of interlocking concerns—ticket agencies, airplane lessors, fiscal agencies and carriers—"North American" is emphasized by defendants to the public.

A whole group of their carriers operates under the name "North American Airlines" [F 56, I 77; F 63(a), I 82]. They fly airplanes prominently marked "North American" [F 45(c) and (d), I 72-73]. "North American" ticket counters are maintained at airports, employing personnel wearing "North American" insignia [F 45(a), I 72].

3. "North American" is also featured in defendants' advertising and other material [F 44, 46; I 71, 73]. Much of that advertising is downright false and deceptive [F 63(a), I 82].* Indeed, many of defendants' activities have

* It moved the Court of Appeals to remark: "Under such circumstances, the public was in need of a champion. But plaintiff had its own vital interest to protect" (CA 12).

already brought the name "North American" into disrepute [F 63, I 81-84].

4. Defendants were not content with taking plaintiff's name. They also imitated two other devices long associated with plaintiff [F 46, I 73]—a triangle enclosing "NAA" and bearing a formalized picture of a bird [F 20, I 61-62], and a slogan, "The North American Way" [F 21, I 62].

5. The "confusion of source" between the parties which defendants intended was "highly probable and likely" [F 61, I 79-80]. What is more, it has actually occurred.

"Instances of actual confusion in the mind of the public were stacked high in the record" (CA 11). Much of the proof came from representative members of the public who had actually been misled; "not . . . stupid, illiterate or careless persons, but persons of ordinary or more than ordinary intelligence, education and prudence" [F 62, I 80-81]. A mass of documentary evidence of confusion was also adduced.

"There was," in short, "overwhelming proof of confusion of source" (CA 11)—precisely the confusion which defendants' acts were "designed, intended and calculated to cause" [F 61, I 79].

ARGUMENT

I.

The decision below accords with, and does not conflict with, this Court's decisions.

None of the four opinions by this Court which petitioners mention (Pet. Br., pp. 6-8) conflicts with the decision below. Three of them were not even cited by petitioners in the Court of Appeals.*

Those cases said or held that a merely geographical name is not a technical trade-mark. No one questions that rule, but it is wholly immaterial here.

This is not a trade-mark case. It is an action based on principles of unfair competition. As pointed out long ago in a leading case on geographical names, "protection is accorded against unfair dealing, whether there be a technical trade mark or not." *Elgin National Watch Co.* v. *Illinois Watch Case Co.*, 179 U. S. 665, 674; see also, *Warner & Co.* v. *Eli Lilly & Co.*, 265 U. S. 526, 531.

That doctrine runs all through the law. A registered trade-mark may be invalid, but relief will be granted if its imitation amounts to unfair competition; "the ground of recovery in the latter instance is that the defendant has

---

* The fourth, *Elgin National Watch Co.* v. *Illinois Watch Case Co.*, 179 U. S. 665, is mentioned here casually (Pet. Br., p. 8) and was as casually cited in the main brief below. Actually it recognizes the very doctrine applied by the Court of Appeals. See *infra*, p. 12.

taken some undue advantage of the plaintiff's reputation, or that of his goods . . ." *Straus* v. *Notaseme Hosiery Co.*, 240 U. S. 179, 181.

Similarly, personal names are not technical trademarks. When they have acquired a secondary meaning, however, they will be protected on the theory of unfair competition. *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 187-188. The same is true of descriptive words which have acquired a secondary meaning. *Coca-Cola Co.* v. *Koke Co. of America*, 254 U. S. 143, 146; *Armstrong Paint & Varnish Works* v. *Nu-Enamel Corp.*, 305 U. S. 315, 335-336.

Precisely the same principle applies to words which, though geographical in their primary sense, have acquired a secondary meaning. "It is undoubtedly true that where such a secondary signification has been acquired, its use in that sense will be protected by restraining the use of the word by others in such a way as to amount to a fraud on the public, and on those to whose employment of it the special meaning has become attached." *Elgin National Watch Co.* v. *Illinois Watch Case Co.*, 179 U. S. 665, 674.

Such a "secondary signification" or meaning "enables the owner to assert an exclusive right to such name as against every one not doing business within the same geographical limits; and even as against them, if the name be used fraudulently for the purpose of misleading buyers as to the actual origin of the thing produced, or of palming off the productions of one person as those of another." *French Republic* v. *Saratoga Vichy Co.*, 191 U. S. 427, 435.

That principle, recognized earlier in *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.*, 138 U. S. 537, 549-551, was applied in *Baglin* v. *Cusenier Co.*, 221 U. S. 580, 592.

Scores of decisions have protected geographical terms, on the ground of unfair competition, after they have acquired secondary significance. Some are cited in Appendix A. Typical is a leading case cited by this Court in *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.*, 240 U. S. 251, 257 (Pet. Br., p. 7).

Shaver v. *Heller & Merz Co.*, 108 Fed. 821 (8 Cir.) exploded the sterile notion—reiterated here (Pet. Br., pp. 2, 6, 13)—that a term which has acquired a secondary meaning cannot be protected against unfair competition because that gives a "practical monopoly" or "exclusive rights" to it so that others may not use it collaterally in its primary geographical sense.

There "American" acquired a secondary meaning to designate plaintiff's bluing. Defendants were enjoined from using it as the name of their product. Like defendants here, they complained that plaintiff had been given a monopoly preventing even descriptive uses of the word in its primary geographical sense. The court rejected the argument incisively (p. 825):

> "They insist that they have the right to state that the goods they sell are made in America, and the right to use the word 'American' for that purpose. The injunction does not forbid them from doing so. They may state in their correspondence or upon their packages, notwithstanding the inhibition of the court, that their ball blue or wash blue is an American manufacture, an American article, or an American

product. They may express the same idea by the declaration that it is a New York, or a New Jersey, or an Iowa product, as the case may be, and they may convey the same thought in many other ways without impinging upon the decree of the court. *The truth is, however,*—and there could be no more conclusive proof of it than the prosecution of this appeal,—*that they do not desire to use the word 'American,' or any other word, for the purpose of declaring that the articles which they sell are made in America. Every one who purchases them either knows or presumes that to be the fact already.* What they seek, and the only thing they really desire, is to use this word to divert to themselves the appellee's trade in American ball blue and in American wash blue, and they well know that they can accomplish this only by using it in those brands for the sole purpose of conveying to the public the falsehood that the goods they sell are made by the appellee."

The cases cited by petitioners are entirely consistent. In two of them the words involved had not acquired a secondary meaning.* A third recognized the right to pro-

---

* "Lackawanna," involved in *Canal Co.* v. *Clark*, 13 Wall. 311 (Pet. Br., p. 6), began as "a recognized description of the [Lackawanna] region, and of course of the earths and minerals in the region" (p. 321), and never acquired any secondary meaning. "All the coal taken from that region is known and has been known for years by the trade, and rated in public statistics as Lackawanna coal" and "the generic name, the comprehensive name for it all is Lackawanna coal" (p. 328).

Similarly, there was no showing in *Columbia Mill Co.* v. *Alcorn*, 150 U. S. 460 (Pet. Br., p. 7), that "Columbia" had acquired a secondary meaning in respect of flour. One reason, doubtless, is that the word was in common use as a flour brand long before plaintiff used it (p. 464); in addition, plaintiff used it only as a grade mark (pp. 466-467).

tection against unfair competition but denied relief because diversity jurisdiction was lacking. *Elgin National Watch Co.* v. *Illinois Watch Case Co.*, 179 U. S. 665, 677. The last did not even discuss the relief available in unfair competition because the words were protected as a technical trademark. *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.*, 240 U. S. 251.*

II.

The "direct conflict" which petitioners profess to find with other decisions is imaginary.

A. The Non-Existent "Conflict" with Earlier Decisions in the Ninth Circuit.

Far from conflicting with the decision below, the lone Ninth Circuit case cited by petitioners, *American Automobile Ins. Co.* v. *American Auto Club*, 184 F. 2d 407, recognized the very principles applied below.

1. When "words descriptive of place" have been used "in connection with goods or business so that the public identifies them with a particular trader they take on a secondary meaning which will be protected against another's deceptive use thereof" (p. 409).

2. Relief "is not to be denied if the businesses are non-competitive" and the "trend of the decisions is to

---

* In the portion quoted out of context by petitioners (Pet. Br., p. 8), the Court was discussing only whether the words involved were a technical trademark. Its reasoning that they were, it may be added, would apply equally here (pp. 256-257).

place less emphasis upon competition and more on confusion" (p. 410).*

Factually, however, the cases are entirely different. For example:

(a) There "American Auto" had been used often "in the identification of automobile clubs. As such it is a common name in that field" (p. 409). Here plaintiff had used "North American" exclusively in the field of aviation for 20 years before defendants' organization was formed [F 24, I 63].

(b) There plaintiffs' trade name had not been advertised to the public for 10 years (p. 408). Here "North American" has been steadily advertised to the public by a dozen different methods [F 19, 22-23; I 60-63].

(c) There the name had acquired at best a "limited and restricted" secondary meaning, because plaintiffs were "known by that name by a select group of informed persons and not by the general public" (p. 409). Here plaintiff *is* known as "North American" to the general public [F 25(d), I 64].

(d) There plaintiffs "disclosed no intent of defendant to deceive the public into believing that its business is a part of plaintiffs' or is to be conducted under auspices of plaintiffs" (pp. 410-411). Here defendants' deceptive intent was established [F 26, 61, 64; I 64, 79-80, 84-85].

(e) There actual confusion was not shown and no likelihood of confusion appeared (pp. 410-411). "The confusion which plaintiffs fear is ephemeral" (p. 411). Here persistent, actual confusion was demonstrated [F 62, I 80-81].

---

* For other Ninth Circuit cases in accord, see Appendix B.

B. The Non-Existent "Conflict" with a California Case.

We will not burden the Court with a detailed analysis of the only California case cited by petitioners, *American Automobile Assn.* v. *American Automobile Owners' Assn.*, 216 Cal. 125, 13 P. 2d 707. It was not even claimed there that the words "American Automobile" had acquired a secondary meaning, doubtless "for the reason that these words are in common use" (13 P. 2d, at p. 710).

The sole question there was whether a symbol showing "AAA" in blue letters on a yellow background was infringed by a different symbol showing "AAOA" in white letters on a red background. [An emblem more closely resembling plaintiff's symbol was enjoined. See 13 P. 2d, at p. 710.] No fraud was shown (13 P. 2d, at pp. 714-715). "The question presented is one of fact. This court is not permitted to substitute its judgment for that of the trial court where, as here, there is substantial evidence to support the trial court's judgment" (p. 715).

Of course the California courts enjoin a confusing use of geographical or descriptive words which have acquired a secondary meaning.* Moreover, where confusion of

---

* In addition to the cases cited in Appendix A, see, *e.g.*, *Academy of Motion Picture Arts and Sciences* v. *Benson*, 15 Cal. 2d 685, 104 P. 2d 650; *Jackson* v. *Universal International Pictures, Inc.*, 36 Cal. 2d 116, 222 P. 2d 433, 436; *Pohl* v. *Anderson*, 13 Cal. App. 2d 241, 56 P. 2d 992, 993; *Rosenthal* v. *Brasley-Krieger Shoe Co., Ltd.*, 19 Cal. App. 2d 257, 64 P. 2d 1109, 1110; *Brown* v. *Hook*, 79 Cal. App. 2d 781, 180 P. 2d 982, 991-992; *Milani* v. *Smith*, 85 Cal. App. 2d 163, 192 P. 2d 830, 832. Many of those cases distinguish the decision cited by petitioners; see also, *Hoyt Heater Co.* v. *Hoyt*, 68 Cal. App. 2d 523, 157 P. 2d 657, 660; *American Distilling Co.* v. *Bellows & Co.*, 102 Cal. App. 2d 8, 226 P. 2d 751, 762.

source is likely, they will enjoin use in a non-competitive business. (See the cases cited in Appendix B.) The "conflict" which petitioners conjure up is imaginary.

C. The Non-Existent "Conflict" with Cases in Other Circuits.

1. Utterly irrelevant is *McGraw-Hill Publishing Co.* v. *American Aviation Associates, Inc.*, 117 F. 2d 293 (Pet. Br., pp. 11-12).

There plaintiff's magazine was called "Aviation" and defendant's "American Aviation." "Aviation" had been used, however, in other magazine titles. [Plaintiff here used "North American" exclusively in the field of aviation for over two decades.] Consequently it was "dubious whether it could be found that plaintiff has acquired a secondary meaning or significance for his title . . ." (p. 296).*

In any event, confusion was deemed unlikely under the very different circumstances there involved (pp. 296-297). For example, the titles differed [here both plaintiff and defendants use "North American"]; defendant's magazine was a technical one, read by a "discriminating audience" unlikely to be confused [here defendants' appeal is to the general public]; there was no evidence of confusion [here actual confusion was abundantly established]; defendant had "not been parasitic upon plaintiff's good-will" [here

---

* Plaintiff's subtitle read: "The Oldest American Aeronautical Magazine." There was no suggestion that plaintiff had acquired a secondary meaning in "American," so of course its descriptive use in the context of defendant's title was not unfair.

fraudulent appropriation of plaintiff's good will was shown]. Factually the case is completely distinguishable.

2. Equally inapposite is *Olin Mathieson Chemical Corp.* v. *Western States Cutlery & Mfg. Co.*, 227 F. 2d 728 (10 Cir.). The language quoted (Pet. Br., pp. 12-13) was concerned with the narrow question—which does not arise here—whether plaintiff's registered trade-marks had been infringed. "What has been said would not, however, warrant appellee" in engaging in "unfair trade competition" (p. 731).

Hence the court turned to the issue of unfair competition (p. 731). It noted that there was "no evidence" that defendant was "attempting to deceive the public." [Here defendants deliberately planned to deceive the public.] Although defendant's knives had been on the market for over 20 years, not one instance of actual confusion was shown. [Here widespread public confusion was established.] The evidence "under the circumstances was not sufficient to establish the likelihood of confusion in the minds of the buying public." [Here, under very different circumstances, public confusion was shown to be not only likely but actual.]

III.

There is no conflict whatever between the decision below and the Civil Aeronautics Board case against one of the petitioners.

The most curious of petitioners' arguments is that the decision below conflicts in some mysterious way with *North American Airlines, Inc.* v. *Civil Aeronautics Board,* decided by the Court of Appeals for the District of Columbia Circuit on June 23, 1955, and No. 410 in this Court.

The argument is the more extraordinary because (1) the Civil Aeronautics Board case involves a different issue, between different parties, arising on different facts, under a statute totally inapplicable here, and (2) the court in that case repeatedly noted that it was *not* concerned with "private litigation" and that "nothing we say is intended to bear one way or the other upon issues which might develop in such an action" (slip opinion, p. 16).

A. The Legal Issues in the Two Cases Are Entirely Different.

The issue in the Civil Aeronautics Board case is whether the Board has jurisdiction to enter an order under §411 of the Civil Aeronautics Act (49 U. S. C. §491) against one of the defendants herein.*

No such issue arises here. That statute was not, and could not have been, invoked here. Statutes like §411 of the Civil Aeronautics Act, which are designed to protect the public interest, confer no private right and cannot be enforced by private litigants.**

---

* Despite the erroneous suggestions to the contrary (Pet. Br., pp. 14-16), only one defendant herein is a party to that case. That is the defendant Twentieth Century Air Lines, Inc., which changed its name to North American Airlines, Inc. after this action was begun [F 57-58, I 77]. Its new name is used in the Civil Aeronautics Board proceeding, which was not instituted until more than a year after this action.

** *Moore* v. *New York Cotton Exchange*, 270 U. S. 593, 603; *Amalgamated Utility Workers (C. I. O.)* v. *Consolidated Edison Co. of New York*, 309 U. S. 261; *Fisher* v. *Star Co.*, 231 N. Y. 414, 427, 132 N. E. 133, 137, cert. den. 257 U. S. 654; *Samson Crane Co.* v. *Union Nat. Sales, Inc.*, 87 F. Supp. 218, 221, affd. on opinion below, 180 F. 2d 896 (1 Cir.).

Conversely, the issue in every private action for unfair competition—whether violation of a private right has occurred or is threatened—does not arise under statutes like §411 of the Civil Aeronautics Act. "Public interest may exist although the practice deemed unfair does not violate any private right." *Federal Trade Comm.* v. *Klesner,* 280 U. S. 19, 27.

Not only do the two cases involve different legal issues, but they are also factually dissimilar.

B. The Two Cases Are Factually As Well As Legally Different.

Here defendants' fraudulent use of the name "North American" was held actionable in view of the public deception ensuing because of the prior association of the *identical* name with *plaintiff* herein.

No such facts were shown in the Civil Aeronautics Board case. Indeed, that case had nothing to do with plaintiff. There the Board acted because it found that the respondent's name was *similar* to "American," which the public associated with *another* concern, American Airlines, Inc., which is not a party hereto.

Thus the ultimate operative facts in the two cases were fundamentally different. So were the evidentiary facts.

For example, in the Civil Aeronautics Board case there was no evidence of any deceit or bad faith (slip opinion, p. 7). Here, on the contrary, defendants fraudulently chose the name "North American" to "capitalize upon and secure to themselves the reputation of plaintiff and its good

will" and to cause public deception [F 26, 61, 64, 67; I 64, 79-80, 84-86].*

Similarly, in that case there was evidence that, in addition to American Airlines, Inc., others in the same field had been using "American" (Pet. Br., p. 15). Here, however, plaintiff's use of "North American" in the field of aviation was exclusive for over two decades before defendants misappropriated that name.

In view of the factual dissimilarities between the two cases, it would be quite immaterial if the Court of Appeals for the District of Columbia Circuit had suggested—or even said—that the respondent therein had not infringed the private rights of American Airlines, Inc. But that is exactly what that court refused to do.

C. Repeatedly the Court of Appeals for the District of Columbia Circuit Pointed Out the Inapplicability of Its Decision to Private Litigation.

In the Civil Aeronautics Board case, the Court of Appeals took pains to emphasize that its decision had no bearing whatever on private litigation. For example, it said (pp. 14-15 of the slip opinion):

---

* Such a fraudulent intent gives rise to a presumption of actionable confusion. See, *e. g.*, *My-T Fine Corp.* v. *Samuels*, 69 F. 2d 76, 77 (2 Cir.); *E. Kahn's Sons Co.* v. *Columbus Packing Co.*, 82 F. 2d 897, 900 (6 Cir.); *Cleo Syrup Corp.* v. *Coca-Cola Co.*, 139 F. 2d 416, 419 (8 Cir.), cert. den. 321 U. S. 781; *Avrick* v. *Rockmont Envelope Co.*, 155 F. 2d 568, 573 (10 Cir.); *Triangle Publications, Inc.* v. *Rohrlich*, 167 F. 2d 969, 972 (2 Cir.); *American Chicle Co.* v. *Topps Chewing Gum, Inc.*, 208 F. 2d 560, 563 (2 Cir.); *Mastercrafters Clock & Radio Co.* v. *Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F. 2d 464, 466-467 (2 Cir.), cert. den. 350 U. S. 832; *National Lead Co.* v. *Wolfe*, 223 F. 2d 195, 202 (9 Cir.), cert. den. 350 U. S. 883.

> "If this were a private suit in which American had charged North American with trade-mark infringement and unfair competition, we would be bound to weigh considerations differing from the public interest criteria which must govern our opinion."

"If this were a private suit," it continued, several questions would have to be considered. Then it added (p. 16 of the slip opinion):

> "But we are not here concerned with the possibility that American might prevail in private litigation, *and nothing we say is intended to bear one way or the other upon issues which might develop in such an action.*"

Thus the opinion in the Civil Aeronautics Board case shows on its face that it has no pertinency here. The "conflict" which petitioners profess to see between the cases is a figment of their imagination.

IV.

The suggestion that the Civil Aeronautics Board case will become moot, if certiorari is denied here, is irrelevant and incorrect.

Petitioners' parting argument comes down to this: if certiorari were denied here, the Civil Aeronautics Board case would become moot; therefore this Court should add to its heavy labors by reviewing the decision below, although it is eminently correct and presents no problem worthy of this Court's consideration.

Even if the premise were correct, the conclusion would be a *non sequitur*. Indeed, it would be far more plausible to argue from that premise that since denial of certiorari here would diminish this Court's burdens, by disposing of the Civil Aeronautics Board case, review should be denied here.

But petitioners' faulty logic needs no exploration, because their major premise is false. Denial of certiorari here will not render the Civil Aeronautics Board case moot.

1. An injunction in a private action does not render moot a proceeding brought to protect the public interest. That is true even if the preventive relief sought by the Government is identical with that already issued in the private litigation. *United States* v. *Borden Co.*, 347 U. S. 514, 517-519.

2. Apart from that, the relief sought in the Civil Aeronautics Board case is not identical with that granted here. Precisely because the issues before the Board were very different from the issues here, its order differed from the injunction below.

The Board ordered the respondent before it to cease and desist from using in air transportation, *inter alia*, "any combination of the word 'American.'" No such provision appears in the judgment herein. Conversely, the Board's order contained no provision like that of the decree below enjoining the defendants' use of names confusingly similar to "North American" [I 89-90].

Consequently the judgment here and the Board's order were far from co-extensive. Innumerable names would be

permissible under the injunction below but not under the Board's order. Compliance with the judgment would not ensure compliance with the Board's order.

For example, the respondent in the Board proceeding could adopt a name such as "Eastern American" or "Western American." Such a name would not violate the injunction below. Yet it would certainly fall within the ambit of the Board's order.

Plainly, therefore, a denial of certiorari here will not render the Civil Aeronautics Board case moot. That case can be reviewed without passing on what petitioners perforce admit are "the collateral"—and, we may add, the specious—"issues presented in the instant petition" (Pet. Br., p. 17).

CONCLUSION

The Petition for a Writ of Certiorari Should Be Denied.

Respectfully submitted,

CHARLES PICKETT,
EDWARD L. COMPTON,
ARCH R. TUTHILL,
Attorneys for Respondent.

CHADBOURNE, PARKE, WHITESIDE & WOLFF,
FLINT & MACKAY,
of Counsel.

APPENDIX A

Cases Protecting Geographical Names Which Had Acquired a Secondary Meaning

Among the California cases are the following:

Name Protected	*Infringing Name*	
Western Iron & Metal Company	Western Iron & Metal Company	*Lutz* v. *Western Iron & Metal Co.*, 190 Cal. 554, 213 Pac. 962
Eastern Columbia	Western Columbia	*Eastern Columbia, Inc.* v. *Waldman*, 30 Cal. 2d 268, 181 P. 2d 865
German Toast	German Toast	*Bradford Baking Co.* v. *Weber Baking Co.*, 43 Cal. App. 570, 185 Pac. 417
San Diego Conservatory of Music	San Diego Conservatory of Music	*Mills* v. *San Diego Conservatory of Music*, 47 Cal. App. 300, 191 Pac. 546; hearing denied
Hudson Bay Fur Company	Hudson Bay Fur Company	*Benioff* v. *Benioff*, 64 Cal. App. 745, 222 Pac. 835
The Carolina Pines	Catalina Pines	*Carolina Pines, Inc.* v. *Catalina Pines*, 128 Cal. App. 84, 16 P. 2d 781
Manteca Beef	Manteca Veal Company	*H. Moffat Co.* v. *Koftinow*, 104 Cal. App. 2d 560, 232 P. 2d 15

Some of the decisions outside California are listed in Appendix B, *infra* pp. iv-v. Others include:

American ball blue and American wash blue	American ball blue and American wash blue	*Shaver* v. *Heller & Merz Co.*, 108 Fed. 821 (8 Cir.)
American Thread Company	North American Thread Company	*American Thread Co.* v. *North American Thread Co., Inc.*, 33 F. Supp. 616 (S. D. N. Y.)

Name Protected	*Infringing Name*	
American Radio Stores	American Radio & Television Stores	*American Radio Stores, Inc.* v. *American Radio & Television Stores Corp.*, 17 Del. Ch. 127, 150 Atl. 180
American Home Benefit Association	United American Benefit Association	*American Home Benefit Assn., Inc.* v. *United American Benefit Assn., Inc.*, 63 Idaho 754, 125 P. 2d 1010
American Shops	American Fashion Shops of Journal Square	*American Shops, Inc.* v. *American Fashion Shops of Journal Square, Inc.*, 13 N. J. Super. 416, 80 A. 2d 573, certification denied, 7 N. J. 576, 83 A. 2d 379
American Rug & Carpet Co.	American Floor Covering Co.	*Rosenberg* v. *Rosenthal*, 135 Misc. 282, 238 N. Y. Supp. 62
American Clay Mfg. Co.	American Clay Mfg. Co. of New Jersey	*American Clay Mfg. Co.* v. *American Clay Mfg. Co. of New Jersey*, 198 Pa. 189, 47 Atl. 936
American Oil Company	American Oil Burner Service	*American Oil Co.* v. *Markus*, 358 Pa. 407, 57 A. 2d 868
Continental Distilling Sales Company	Continental Wine & Liquor Company	*Continental Distilling Sales Co.* v. *Brancato*, 173 F. 2d 296 (8 Cir.)
German-American Button Company	German-American Hand Crochet Button Works	*German-American Button Co.* v. *A. Heymsfeld, Inc.*, 170 App. Div. 416, 156 N. Y. Supp. 223
National Tool Salvage Company	National Tool Salvage Industries	*National Tool Salvage Co.* v. *National Tool Salvage Industries, Inc.*, 186 Misc. 833, 60 N. Y. S. 2d 308
Northern Metal Company	Great Northern Metal Company	*Northern Metal Co.* v. *Maier*, 337 Pa. 257, 11 A. 2d 140

Name Protected	*Infringing Name*	
rthwest Ready Roof- Company	Northwest Ready Roofing Company	*Northwest Ready Roofing Co.* v. *Antes*, 117 Neb. 121, 219 N. W. 848
ited States Ozone mpany of America	United States Ozone Company	*United States Ozone Co.* v. *United States Ozone Company of America*, 62 F. 2d 881 (7 Cir.)
ited States Light & ating Company of ine	United States Light & Heating Co. of New York	*United States Light & Heating Co. of Maine* v. *United States Light & Heating Co. of New York*, 181 Fed. 182 (C. C. S. D. N. Y.)
ited States Dental sociation	U. S. Dental Rooms	*Cady* v. *Schultz*, 19 R. I. 193, 32 Atl. 915
estern Auto Supply	Western Auto Salvage Company and Western Auto Parts Company	*Western Auto Supply Co.* v. *Knox*, 93 F. 2d 850 (10 Cir.)
estern Ranchman tfitters	Western Outfitters	*Bernstein* v. *Friedman*, 62 Wyo. 16, 160 P. 2d 227

APPENDIX B

Cases Protecting Marks or Names Against Non-Competitive Use Where Confusion of Source Was Likely

1. *Geographical name* cases of this sort include:

Prevailing Party	*Losing Party*	
Wholesaler of furs, not selling to retailers in United States, popularly known as "Hudson's Bay Company"	Retailer of fur products using name "Hudson Bay Fur Co."	*Phillips v. Governor & Company of Adventurers of England Trading into Hudson's Bay*, 79 F. 2d 971 (9 Cir.)*
Producer of "Del Monte" food products but not oleomargarine	Distributor of "Del Monte" oleomargarine	*Del Monte Special Food Co. v. California Packing Corp.*, 34 F. 2d 774 (9 Cir.)
Tobacco manufacturer, selling only at wholesale, named "British-American Tobacco Company"	Retailer of tobacco products named "British-American Cigar Stores Company"	*British-American Tobacco Co., Ltd. v. British-American Cigar Stores Co.*, 21 Fed. 933 (2 Cir.)
Producer, refiner and distributor of crude oil and its products, using name "Indian Territory Illuminating Oil Company"	Small producer of crude oil, selling it in the pipe line, using name "Indian Territory Oil & Gas Company"	*Indian Territory Oil & Gas Co. v. Indian Territory Illuminating Oil Co.*, 95 F. 2d 711 (10 Cir.), cert. den. 305 U. S. 607
Manufacturer of "Hudson" automobiles which made no tires	Manufacturer of "Hudson Cord" automobile tires	*Hudson Motor Car Co. v. Hudson Tire Co.*, 21 F. 2d 453 (D. N. J.)
Manufacturer of non-carbonated beverages, using name "American Products Company"	Manufacturer of carbonated beverages using same name	*American Products Co. v. American Products Co.*, 42 F. 2d 488 (E. D. Mich.)

* For like decisions, see *Buckspan v. Hudson's Bay Co.*, 22 F. 2d 721 (5 Cir.), cert. den. 276 U. S. 628, and *Governor and Company of Adventurers of England Trading into Hudson's Bay v. Hudson Bay Fur Co.*, 33 F. 2d 801 (D. Minn.).

COPY BOUND

Prevailing Party	*Losing Party*	
Brewer of stout popularly known as "Dublin Stout"	Manufacturer of "Dublin Stout Style" malt extract	*Arthur Guinness, Son & Co. v. Oscar Von Bernuth, Inc.*, 14 F. Supp. 210 (S. D. N. Y.)
National bank named "Colorado National Bank of Denver"	Non-banking company named "Colorado National Company"	*Colorado National Co. v. Colorado National Bank of Denver*, 95 Colo. 386, 36 P. 2d 454
Operator of "Churchill Downs" race track	Manufacturer of "Churchill Downs" whiskey	*Churchill Downs Distilling Co. v. Churchill Downs, Inc.*, 262 Ky. 567, 90 S. W. 2d 1041
Maker of knit underwear (other than lumbermen's underwear) named "Northwestern Knitting Company"	Maker of knit sweaters (and formerly lumbermen's underwear) using name "Northwestern Knitting Mill"	*Northwestern Knitting Co. v. Garon*, 112 Minn. 321, 128 N. W. 288
Manufacturer of "Wayne County" foods made from apples	Retailer selling "Wayne County" apple brandy	*Wayne County Produce Co. v. Gordon-O'Neill Co., Inc.*, 249 App. Div. 743, 291 N. Y. Supp. 641, affd. 274 N. Y. 556, 10 N. E. 2d 549
Operator of "Columbia" television broadcasting stations	Retailer of television sets using "Columbia" name	*Columbia Broadcasting System, Inc. v. Columbia of New York, Inc.*, 97 N. Y. S. 2d 455, affd. 277 App. Div. 856, 98 N. Y. S. 2d 384

2. *Descriptive words* were protected in such cases as the following:

Non-profit corporation organized to promote motion picture industry, giving annual "Academy Awards"	Operator of school for prospective motion picture actors, called "Hollywood Motion Picture Academy"	*Academy of Motion Picture Arts and Sciences v. Benson*, 15 Cal. 2d 685, 104 P. 2d 650
Manufacturer of "Keep-Klean" toilet brushes	Manufacturer of "Sta-Kleen" tooth brushes	*Florence Mfg. Co. v. J. C. Dowd & Co.*, 178 Fed. 73 (2 Cir.)

CLOSE IN CENTER

Prevailing Party	*Losing Party*	
Manufacturer of "Overland" automobiles	Retreader of "Overland" tires	*Akron-Overland Tire Co. v. Willys-Overland Co.*, 27 Fed. 674 (3 Cir.)
Manufacturer of "Prophylactic" tooth brushes	Distributor of "Prophylactic" tooth powder	*Pro-phy-lac-tic Brush Co. v. Abraham & Straus, Inc.*, 11 F. Supp. 660 (E. D. N. Y.)
Manufacturer of "Realistic" permanent wave devices	Operator of "Realistic" beauty salon giving permanent waves	*Philad Co. v. Murray Beauty Salon*, 14 F. Supp. 626 (S. D. Ohio), app. dismissed, 96 F. 2d 1019
"Metropolitan Opera Association" producing grand opera	"Metropolitan Opera Association" intended to train opera singers in small companies	*Metropolitan Opera Assn. Inc. v. Metropolitan Opera Assn. of Chicago, Inc.*, 8 F. Supp. 127 (N. D. Ill.)
Publisher of "Vogue," women's magazine	Operator of "Vogue School of Fashion Models"	*Conde Nast Publications Inc. v. Vogue School of Fashion Modelling, Inc.*, 105 F. Supp. 325 (S. D. N. Y.)
Vendor of "Standard Oil" fuel oil for burner consumption	Repairer of fuel oil burners, using name "Standard Oil Burner Service"	*Socony-Vacuum Oil Co. Inc. v. Lafariere*, 48 N. Y. S. 2d 421
"Metropolitan Opera Association" producing grand opera	Phonograph record producer advertising recordings "featuring the Metropolitan Symphony Orchestra"	*Metropolitan Opera Assn. Inc. v. Pilot Radio Corp.*, 189 Misc. 505, 68 N. Y. S. 2d 789

3. *Personal names* were protected in such cases as the following:

Manufacturer of "Horlick's" powdered malted milk	Operator of "Horluck's" retail stores dispensing malted milk beverage	*Horlick's Malted Milk Corp. v. Horluck's, Inc.*, 59 F. 2 13 (9 Cir.)
Manufacturer of "Ford" automobiles	Automobile retailer falsely stating it was "Ford auto agency"	*Ford Motor Co. v. Benjamin E. Boone, Inc.*, 2 Fed. 335 (9 Cir.)

COPY BOUND

Prevailing Party	*Losing Party*	
ormer manufacturer of tomobile carburetors d engines, using name Winfield Carburetor & fg. Co."	Manufacturer of automobile jacks and wrenches, using name "Winfield Manufacturing Company"	*Winfield v. Charles*, 77 Cal. App. 2d 64, 175 P. 2d 69
perator of "Tarano's" restaurant, using cktail sauce	Manufacturers of "Tarantino's Cocktail Sauce"	*MacSweeney Enterprises, Inc. v. Tarantino*, 106 Cal. App. 2d 504, 235 P. 2d 266
Manufacturer of wearg apparel, selling only wholesale, using name Jackman of Hollywood"	Retailer of wearing apparel using name "Jackmau of Hollywood"	*Jackman v. Mau*, 78 Cal. App. 2d 234, 177 P. 2d 599
Manufacturer of "Yale" cks and keys	Manufacturer of "Yale" flashlights and batteries	*Yale Electric Corp.* v. *Robertson*, 26 F. 2d 972 (2 Cir.)
Manufacturer of "Warman's" fountain pens d mechanical pencils	Seller of "Waterman" razor blades	*L. E. Waterman Co. v. Gordon*, 72 F. 2d 272 (2 Cir.)
Retailer of "Dunhill" nokers' supplies	Retailer of shirts using name "Dunhill Shirt Shop"	*Alfred Dunhill of London, Inc. v. Dunhill Shirt Shop, Inc.*, 3 F. Supp. 487 (S. D. N. Y.)
Manufacturer of "Lin-in" automobiles	Used car dealer, employing name "Lincoln Automobile Company"	*Lincoln Motor Co. v. Lincoln Automobile Co.*, 44 F. 2d 812 (N. D. Ill.)
Manufacturer of "Ford" tomobiles and fertil-ers	Manufacturer of "Ford" insecticides	*Ford Motor Co. v. Ford Insecticide Corp.*, 69 F. Supp. 935 (E. D. Mich.)
Manufacturer of "Tom wyer" boys' wearing pparel	Manufacturer of "Tom Sawyer" paint	*Elder Mfg. Co. v. Martin Trenkle Co.*, 90 F. Supp. 889 (E. D. Ark.)
Packer of "Libby's" eats	Operator of "Libby's Super Market"	*Libby, McNeill & Libby v. Libby*, 103 F. Supp. 968 (D. Mass.)

CLOSE IN CENTER

Prevailing Party	*Losing Party*	
Operator of "Statler" hotels	Operator of "Statler" retail flower shop	*Hotels Statler Co., Inc. v. Chase*, 104 F. Supp. 53 (S. D. Cal.)
Manufacturer of "Du-Pont" combs and other toilet articles	Manufacturer of "Du-Pont" razor blades	*E. I. DuPont de Nemour & Co. v. DuPont Safet Razor Corp.*, 82 A. 2d 38 (Del. Ch.)
Retailer of jewelry using name "Kay Jewelry Company"	Retailer clothier using name "Kay's Credit Clothiers"	*Kay Jewelry Co. v. Kay loff*, 204 Ga. 209, 49 S. E 2d 19
Retailer of jewelry named "Tiffany & Co."	Producer of "Tiffany" motion pictures	*Tiffany & Co. v. Tiffa Productions, Inc.*, 147 Mis 679, 264 N. Y. Supp. 45 affd. 237 App. Div. 8 260 N. Y. Supp. 821, aff 262 N. Y. 482, 188 N. E 30
Manufacturer of "Martha Washington" candies which formerly made ice cream	Manufacturer of "Martha Washington" frozen confectionery	*Martha Washington Ca dies Co., Inc. v. Mart Washington Ice Cream C Inc.*, 280 App. Div. 2 113 N. Y. S. 2d 119, ap dismissed, 304 N. Y. 9 110 N. E. 2d 896
Packers of "Armour" meats	Concern, using "Armour" name, arranging for delivery of meats to Europe	*Armour & Co. v. Armo Shipping Corp.*, 175 Mis 695, 25 N. Y. S. 2d 47

4. *Other non-fanciful marks*, including suggestive, honorific an commonly used terms, were protected in such cases as the following:

Operator of "Safeway" chain stores selling toilet paper, etc.	Seller of "Safe Way" toilet seat covers to concerns having public rest rooms.	*Safeway Stores, Inc. Dunnell*, 172 F. 2d 649 Cir.)
Processors of "Sunsweet" prunes, used for food and making prune juice	Manufacturer of "Sunsweet" fruit juices for making soft drinks	*California Prune & Apri Growers Assn. v. H. Nicholson Co.*, 69 Cal. A 2d 207, 158 P. 2d 764

COPY BOUND C

Prevailing Party	*Losing Party*	
Manufacturer of various "Swooner" articles of feminine wearing apparel but not bobby socks	Retailer selling "Swooner" bobby socks	*Cole of California, Inc. v. Grayson Shops, Inc.*, 72 Cal. App. 2d 772, 165 P. 2d 963
Publisher of "Seventeen" magazine for girls	Manufacturer of "Miss Seventeen" girdles	*Triangle Publications, Inc. v. Rohrlich*, 167 F. 2d 969 (2 Cir.)
Manufacturer of "Admiral" electric ranges, refrigerators, radios, etc.	Retailer of "Admiral" electric sewing machines and vacuum cleaners	*Admiral Corp. v. Penco, Inc.*, 203 F. 2d 517 (2 Cir.)
Manufacturer of "Duro" internal combustion engines	Manufacturer of "Duro" spark plugs	*Duro Co. v. Duro Co.*, 27 F. 2d 339 (3 Cir.)
Manufacturer of "Aladdin" kerosene lamps	Manufacturer of "Aladdin" portable electric lamps	*Mantle Lamp Co. of America v. Aladdin Mfg. Co.*, 78 F. 2d 426 (7 Cir.), cert. den. 296 U. S. 639
"Jewel Tea Company" operating grocery stores	Operator of "Jewel Milk Stores" selling dairy products principally, ice cream and some groceries	*Jewel Tea Co., Inc. v. Kraus*, 187 F. 2d 278 (7 Cir.)
Publisher of "Seventeen" magazine for girls	Manufacturer of "Seventeen" girls' dresses	*Hanson v. Triangle Publications, Inc.*, 163 F. 2d 74 (8 Cir.), cert. den. 332 U. S. 855
Manufacturer of "Eternit" roof shingles	Applier of shingles to roofs, using name "Eternit Roofing Corporation"	*American Insulation Co. v. Eternit Roofing Corp.*, 14 F. 2d 235 (E. D. N. Y.)
Manufacturer of women's hosiery using orchid design	Manufacturer of lingerie using orchid design	*Northmont Hosiery Corp. v. True Mfg. Co.*, 100 F. Supp. 909 (E. D. Wis.)
Publisher of "Esquire" men's magazine	Retailer operating "Esquire" men's clothing store	*Esquire, Inc. v. Maira*, 101 F. Supp. 398 (M. D. Pa.)
Packer and wholesaler of "First Prize" meats, selling to no consumers	Operator of retail "First Prize Meat Market"	*Albany Packing Co., Inc. v. Crispo*, 227 App. Div. 591, 237 N. Y. Supp. 614, affd. 253 N. Y. 607, 171 N. E. 803

Prevailing Party	*Losing Party*	
Charitable corporation known as "Golden Slipper Club"	Operator of "Golden Slipper" night club	*Golden Slipper Square Club v. Golden Slipper Restaurant & Catering, Inc.*, 37 Pa. 92, 88 A. 2d 734
Manufacturer of "Premier" bicycles	Manufacturer of "Premier" bicycle tubes	*Premier Cycle Co., Ltd. v. Premier Tube Co., Ltd.*, 12 T. L. R. 481
Publisher of "The Times" newspaper	Distributor of "The Times" bicycles	*Walter v. Ashton*, (1902) 2 Ch. 282

5. Other Ninth Circuit cases on the point include *Brooks Bro* v. *Brooks Clothing of California, Ltd.*, 60 F. Supp. 442, 451 (S. D. Cal.), affd. on opinion below, 158 F. 2d 798, cert. den. 331 U. S. 824; *Stork Restaurant, Inc.* v. *Sahati*, 166 F. 2d 348; *Sunbeam Furnitur Corp.* v. *Sunbeam Corp.*, 191 F. 2d 141, rehearing denied, 191 F. 2 731. The rule was recognized in *Schwartz* v. *Slenderella Systems California, Inc.*, 43 Cal. 2d 107, 271 P. 2d 857, although relief wa denied under the circumstances of that particular case.

COPY BOUND CLOSE IN CENTER